Supreme Court, U.S.
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# In The Supreme Court of the United States

ANTHONY J. DEGIDIO,

*Petitioner*

v.

WEST GROUP CORPORATION; THE THOMSON CORPORATION; WEST LICENSING CORPORATION,

*Respondents*

ON PETITION FOR WRIT OF CERTIORARI
TO THE COURT OF APPEALS FOR THE SIXTH CIRCUIT

## PETITION FOR WRIT OF CERTIORARI

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## QUESTIONS PRESENTED

Whether the Court of Appeals was correct in applying a de novo standard of review for ultimate and subsidiary issues of fact in its review of a Lanham Act trademark infringement claim.

What facts must a court examine in order to determine whether or not a there is a "likelihood of confusion" under 15 USC § 1052 and 15 USC § 1125.

## PARTIES TO THE PROCEEDING

*Petitioner*

Petitioner is an individual and resident of the state of Ohio who operates the internet web site <lawoffices.net>.

*Respondents*

Respondent West Licensing Corporation is a Delaware Corporation, with its principal place of business in Wilmington Delaware. Respondent Thomson Corporation is a Canadian corporation with it's principal place of business in the U.S. in Stamford, CT. Respondent West Group Corporation is a wholly owned division of the Thomson Corporation, and a Delaware corporation with it's principal place of business in St. Paul, MN. Respondents are engaged in the business of legal publishing, own and operate the West Legal Directory and the internet web site <lawoffice.com>.

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## PETITION FOR A WRIT OF CERTIORARI

Petitioner respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Sixth Circuit in this case.

## OPINIONS BELOW

The opinion of the Court of Appeals (Appendix ("App."), *infra,* 1a-18a) is reported at 355 F.3d 506, (6th Cir. Ohio 2004). The opinion of the District Court (App., *infra,* 19a-48a) is reported at 191 F. Supp. 2d 904, (N.D. Ohio 2002).

## JURISDICTION

The judgment of the Court of Appeals was entered on January 14, 2004. App., *infra,* 1a. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

## STATUTES AND RULES INVOLVED

Pertinent provisions of the Lanham Act, 15 U.S.C. § 1052, and, 15 U.S.C. § 1125. are set forth at App. *infra*, 49a-58a.

## STATEMENT OF THE CASE

This case is based upon a trademark infringement claim brought pursuant to 15 U.S.C. § 1125 of the Lanham Act. It arises from Respondent's use of an almost identical internet domain name to provide or advertise the same services first rendered by Petitioner some three years earlier.

On January 25, 1996, the Petitioner registered the Internet domain name <lawoffices.net>. Shortly thereafter

he began to use the domain name in conjunction with the provision of five distinct and independent services. The <lawoffices.net> designation was used in conjunction with the service of providing vanity email addresses[1], third level domain names and hosting of websites at those domain names[2], the provision of legal information relating to cyberlaw issues, a searchable online database of internet domain names for sale, and a searchable online directory of attorneys.

In March of 1999 Respondents acquired the <lawoffice.com> domain name. By June of 1999 Respondents began to use <lawoffice.com> to provide or promote the West Legal Directory (an online database of attorneys), web site hosting and third level domains at <lawoffice.com>, email services @lawoffice.com, and legal information at the <lawoffice.com> web site. Respondents thus provided identical services under an almost identical mark.

Based upon the foregoing the Petitioner brought suit in the Northern District of Ohio for trademark infringement and other related causes of action.

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[1] A vanity email address using the <lawoffices.net> domain name might be "tony@lawoffices.net". These can be set to forward to other email addresses and retained for life instead of changing one's email address every time a new service provider is used.

[2] A third level domain name is placed in front of the domain name and separated by a period. The owner of a domain name can create these and provide web hosting for others under this third level domain name. For example see http://marionohiolawyer.lawoffice.com, where Respondents have used the <lawoffice.com> domain name to create the third level domain name "marionohiolawyer" for the Piacentino law firm.

### A. The Proper Infringement Analysis and Permissible Scope of Appellate Review Set by this Court in *Icicle Seafoods*

It is widely accepted that a claim of trademark infringement is established when a plaintiff proves that: (1) its mark is valid and legally protectable; (2) it owns the mark; and (3) the defendant's use of the mark to identify its goods or services is likely to create confusion concerning the origin of those goods or services. *Commerce Nat'l Ins. Servs. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432 (3rd cir. 2000).

Common law ownership rights in an unregistered mark "flow only from prior appropriation and actual use in the market," *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1105 (6th Cir.1991). Validity of the mark is determined by evaluating the mark's level of distinctiveness. Following the classic formulation set out by Judge Friendly, they may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. *Two Pesos v. Taco Cabana*, 505 U.S. 763, 768 (1992). The latter three categories of marks, because their intrinsic nature to serve to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection upon first use in commerce[3].

A "merely descriptive" mark, in contrast, describes the qualities or characteristics of a good or service, and this type of mark may be registered only if the registrant shows that it has acquired secondary meaning, i.e., it "has become

[3] There is no dispute that the Petitioner made first use of the mark at issue.

distinctive of the applicant's goods in commerce." §§ 2(e), (f), 15 U. S. C. §§ 1052(e), (f). *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985).

It is important to note that a term that is in one category for a particular product may be in a quite different category for another product. "The proper categorization will vary with the relationship between the term and the product or service. 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:71 at p. 11-137 (4th ed. 2001). Additionally, "a mark that connotes two meanings – one possibly descriptive and the other suggestive of some other association – can be called "suggestive" because the mark is not "merely" descriptive. For example the mark POLY PITCHER on polyethylene pitchers both connotes a description of the plastic ingredient of the product and also is reminiscent or suggestive of Molly Pitcher of Revolutionary time." *Id.* at § 11:28-29.

Use of the same mark on different goods is common. Anyone familiar with the Japanese company Yamaha knows that they make motorcycles, stereo equipment, skis, and musical instruments. If "Yamaha" meant motorcycle in Japanese then that use would be generic and not protectable but the other uses might be arbitrary and thus protectable.

After determining that there is a mark deserving protection courts consider whether or not there is a likelihood of confusion. The Lanham Act, in § 43(a), provides a cause of action where the second comer uses a "... word, term, name, symbol, or device, or any combination thereof . . . which . . . is likely to cause confusion . . . as to the origin, sponsorship, or approval of his or her goods . . . . " 15 U.S.C. § 1125(a). *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000). The likelihood of confusion

analysis is fact intensive. In the 6th Circuit it normally considers the strength of the plaintiff's mark, the relatedness of the goods or services, the similarity of the marks, any evidence of actual confusion, similarity in the marketing channels used by the parties; the likely degree of purchaser care, the defendant's intent in selecting the mark and the likelihood of expansion of the product lines. *Frisch's Restaurants, Inc. v. Elby's Big Boy*, 670 F.2d 642, 648 (6th Cir. 1982). Many trial courts disfavor deciding trademark cases in summary judgments because the ultimate issue is so inherently factual. See, e.g., *United States Jaycees v. San Francisco Junior Chamber of Commerce*, 354 F. Supp. 61, 68-69 (N.D. Cal. 1972), aff'd, 513 F.2d 1226 (9th Cir. 1975) (per curiam).

When reviewing issues of fact a Court of Appeals is limited to "review" and is not authorized to act as a fact-finder *de novo*. In *Icicle Seafoods, Inc. v. Worthington*, 475 U.S. 709 (1986) this Court found the 9th Circuit Court of Appeals had engaged in improper fact-finding where the District Court made no finding on a question of fact and the Court of Appeals then substituted its own opinion and disposed of the case. This Court ruled that if a court of appeals believes that a district court has failed to make findings of fact essential to a proper resolution of a legal question, it should remand to the District Court to make those findings. If a Court of Appeals is of the view that the findings of a District Court are "clearly erroneous" within the meaning of Fed. R. Civ. P. 52(a), it can set them aside on that basis. If a court of appeals believes that a district court's factual findings are unassailable, but that the proper rule of law is misapplied to those findings, it can reverse the district court's judgment based upon the law, but it should not simply make factual findings on its own. *Id.* at 714.

**B. The Proceedings Below**

The District Court did acknowledge that there were five different services being provided. App., *infra*, 20a. The District court also found that <lawoffices.net> was "...ostensibly suggestive, at least insofar as related to the domain name sales, website hosting, and vanity email service." App., *infra*, 30a. The court found that LAWOFFICES was descriptive and lacked secondary meaning as to the attorney database and ended its analysis without considering likelihood of confusion with respect to the suggestive uses. Since the District Court did find the mark to be suggestive as to the remaining services it should have completed its infringement analysis by addressing the likelihood of confusion factors with respect to those services. Instead it made no factual findings as to likelihood of confusion at all.

Petitioner appealed the District Court decision and raised two issues on appeal. First, and relevant to this Petition, he sought review based upon the District Court's failure to consider the use of LAWOFFICES as to each of the services. Second, the Petitioner claimed the District Court erred when it found LAWOFFICES had not acquired secondary meaning as it improperly applied the factors relating to intentional copying, length, duration and exclusivity of use, and evidence of consumer testimony.

The Court of Appeals of Appeals fully addressed the issue of secondary meaning relating to the use of LAWOFFICES for an attorney database but did not address the first issue relating to the use of LAWOFFICES for email addresses, third level domain names and hosting of websites at those domain names, the provision of legal information

relating to cyberlaw issues, and a searchable online database of internet domain names for sale.

Instead of remanding the case back to the trial court to make factual findings on likelihood of confusion, the Court of appeals dispensed with the issue stating:

> Finally, as Defendant points out, the main problem with Plaintiff's position is that Defendant in this case is not even accused of providing those services (i.e. domain name sales, website hosting, and vanity e-mail) on the website that allegedly infringed on Plaintiff's mark.(n13) One can imagine a hypothetical case in which a defendant would provide services identical to Plaintiff's on a LAWOFFICE.COM website. That case would present an interesting question of whether "LAWOFFICES" is a suggestive or a descriptive mark with regard to those services. Since the present controversy does not involve such a fact pattern, we do not address the question of whether "LAWOFFICES" could ever be a suggestive mark.(n14) App., *infra*, 9a.

It is perhaps ironic and unfortunate that the "interesting question" the Court referred to was the one that was directly put to them. The Court's error is the result of several misunderstandings. First the Court placed itself in a position to review each of the factual considerations regarding likelihood of confusion without the District Court having made any findings as to those factors. Second, once it took fact finding upon itself, the panel majority apparently did not conduct a meaningful review of the Joint Appendix as it had statements from West admitting that it provided those other

services.[4] The panel majority did not actually conduct any reasoned analysis of likelihood of confusion, using the factors employed in the 6th Circuit, but merely issued a conclusion without analysis. But even if all of the above errors did not occur the panel majority was simply incorrect in its apparent belief that an infringer must provide the same services before there can be a likelihood of confusion. Likewise it is not necessary that the infringer provide those services on that particular website. While similarity of the services is one factor employed by the 6th Circuit, it is not the entire analysis. The likelihood of confusion factors take into consideration the similarity of the mark, similarity of services, the likelihood of expansion and numerous other factors not addressed by either Court. So instead of answering the interesting question put directly to it, the panel majority improperly engaged in de novo fact finding, made a decision based upon an incomplete review of the record, and an incorrect understanding of the law. Specifically the Court

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[4] The Joint Appendix presented to the Court of Appeals included at least two clear cut admissions from Respondents that used LAWOFFICE for the same services as Petitioner. On page 477 of the Joint Appendix West stated to the USPTO in its trademark application that "Applicant has used the LAWOFFICE.COM mark in connection with its provision of various legal information and marketing services since June 1999. Among the extensive online resources offered to consumers by Applicant in connection with the LAWOFFICE.COM mark are authoritative information covering more than 400 legal topics ... the Web's largest directory of more than one million lawyers...Moreover, Applicant offers various services to law firms and legal practitioners in connection with LAWOFFICE.COM mark, including e-mail and web site creation and hosting services". Additionally West submitted an affidavit from its Senior Director for Business Development that stated West had redirected traffic from its attorney directory site to <lawoffice.com>, that lawoffice.com offered topical articles on the law, and that West also offers various fee-based services to law firms and law practitioners through its Legal Directory including e-mail and website creation and hosting services. JA 258-259.

ruled as if the entire infringement analysis hinged in the provision of identical goods or services.

## REASONS FOR GRANTING THE PETITION

### I. THE DECISION OF THE PANEL MAJORITY IS INCONSISTENT WITH THIS COURT'S DECISION IN *ICICLE SEAFOODS* AND WITH THE ANALYSIS USED BY OTHER CIRCUITS.

In *Icicle Seafoods* this Court clearly prohibited the sort of de novo fact finding engaged in by the Majority Panel. The reasons for the prohibition are abundantly clear. The District Court is in a better position to make factual findings. In this instance the Court of Appeals proved this point by incorrectly suggesting the parties did not provide the same services, contrary to clear evidence in the Joint Appendix. The proper course of action would have been a remand. The Panel Majority declined to do so and as a result made an incorrect assessment of the facts and relevant law without allowing for briefing on these issues by the Petitioner. The result was a review which cannot be considered meaningful or fair.

### II. THE ISSUES ARE OF WIDESPREAD IMPORTANCE

The development of computers and the internet has spurned a growth in intellectual property. With this growth has come an increase in litigation. Between 1992 and 1996, there was a twenty-five-percent increase in the number of intellectual property infringement lawsuits filed in federal courts[5]. The U.S. Patent and Trademark Office has gone

[5] Melvin Simensky and Eric C. Osterberg, The Insurance and Management of Intellectual Property Risks, 17 Cardozo Arts & Ent. L.J., 321, 321 (1999) (citing Bureau of Justice Statistics, U.S. Dep't of Justice,

from processing 130,000 applications in 1990 to 258,000 applications in 2002[6]. Trademark cases commenced in US district courts 2419 in 1993 to 3470 in 2002[7] showing an increase of 40% . In each and every trademark dispute the issue of likelihood of confusion must be analyzed.

Other Courts may read this decision and rely on the Court's apparent ruling that a likelihood of confusion cannot exist where the parties are not in competition (even though they were in competition in this case). This is especially true given the fact that the Panel Majority did not even cite the factors relating to likelihood of confusion, let alone seriously analyze them. Given the magnitude of litigation in this area guidance from this Court is needed to advise the Circuits as to what facts are relevant to likelihood of confusion, and the importance of considering the evidence before making rulings in this regard. While likelihood of confusion is part of the infringement analysis and statutes, this Court has never taken the opportunity to discuss what facts are relevant to a likelihood of confusion analysis. As a result the Circuits are left without guidance as to the proper analysis.

## III. THE DECISION BELOW IS WRONG

The panel majority clearly acted contrary to this Court's holding in *Icicle Seafoods* and contrary to well established trademark principles. Without a factual finding by the District Court as to the likelihood of confusion factors for the

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Judicial Bus. of the U.S. Courts, Report of the Director, tbl. C-2A at 140 (1996)).

[6] See graph of USPTO statistics at http://www.fticonsulting.com/ip/presentations/ip_chart_feb/slide0008_files/slide0050.htm.

[7] http://www.fticonsulting.com/ip/presentations/ip_chart/slide0012_files/slide0012.htm.

services it found to be suggestive, there can be no meaningful review. By engaging in *de novo* fact finding, misconstruing the record, and then erring in the tiny portion of the likelihood of confusion analysis it did perform, the panel has deprived Petitioner of a meaningful review. The Panel Majority has so far departed from the accepted and usual course of judicial proceedings, and sanctioned such a departure by a lower court, as to call for an exercise of this Court's supervisory power.

## CONCLUSION

Both the District Court and the Court of Appeals would no doubt acknowledge the difficulty they had with the issues in this case. The answers are not readily apparent but are plainly important as they affect trademark rights in general as well as rights based upon Internet domain names. One cannot discount the challenges which the courts face when attempting to review trademark cases, but given the increasing importance of these rights, the increase in the number of disputes, the Circuits should be provided with some guidance from this Court.

Only this Court can properly advise the District and Circuit Courts as to the law and proper procedures addressed herein. Accordingly, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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**APPENDIX**

(Footnotes trail at end of each document)

No. 02-3739

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

ANTHONY J. DEGIDIO,
Plaintiff-Appellant,

v.

WEST GROUP CORPORATION; THE THOMSON CORPORATION; WEST LICENSING CORPORATION,

Defendants-Appellees.

December 5, 2003, Argued
January 14, 2004, Decided

COUNSEL: ARGUED: Anthony J. DeGidio, Jr., Toledo, Ohio, for Appellant.

Robert L. Raskopf, WHITE & CASE, New York, New York, for Appellees.

ON BRIEF: Anthony J. DeGidio, Jr., Toledo, Ohio, for Appellant.

Robert L. Raskopf, Jennifer Johnson Millones, WHITE & CASE, New York, New York, for Appellee. Richard M. Kerger, KERGER & KERGER, Toledo, Ohio, for Appellees

JUDGES: Before: KENNEDY, MARTIN, and MOORE, Circuit Judges. KENNEDY, J., delivered the opinion of the court, in which MARTIN, J., joined. MOORE, J, delivered a separate opinion concurring in part and concurring in the judgment.

OPINIONBY: KENNEDY

OPINION: KENNEDY, Circuit Judge.

Plaintiff appeals the district court's order granting summary judgment to Defendants. Plaintiff DeGidio argues that the district court erred when it determined that his mark, LAWOFFICES, was descriptive and that it had not acquired secondary meaning. We affirm.

BACKGROUND

This case represents an attempt by Plaintiff, Anthony DeGidio, to obtain trademark protection for the mark LAWOFFICES.(n1) Plaintiff is the registrant of the domain name "lawoffices.net" and alleged founder and owner of the corresponding website,(n2) which provides a directory of forty attorneys, legal information relating to cyberlaw issues, a vanity e-mail service,(n3) listing of domain names for sale,(n4) and a hosting service for legal related websites. Plaintiff, however, does not own either a federal or state registration for the LawOffices.net designation.(n5)

Defendants, West Group Corporation, The Thompson Corporation, and West Licensing Corporation, utilize the designation Lawoffice.com(n6) and the domain name "lawoffice.com"(n7) to market the West Legal Directory, which serves as an online resource for various legal information.(n8)

Plaintiff filed this trademark action on August 24, 1999 alleging violations of the Ohio Deceptive Trade Practices Act, OHIO REV. CODE ANN. § 4165.01 et seq. (Count I); unauthorized use of trademark pursuant to OHIO REV. CODE ANN. §1329 et seq. (Count II);(n9) common law unfair competition (Count III); false designation of origin under 15 U.S.C. § 1125(a) (Count IV); federal trademark dilution (Count V); common law dilution (Count VI); and the tort of misappropriation (Count VII). Both parties moved for summary judgment. The district court found that LAWOFFICES was not a protectible mark because it was descriptive and it had not acquired a secondary meaning. Accordingly, the district court granted Defendants' motion for summary judgment as to counts I-VI, but not VII. Plaintiff dismissed count VII and thereafter timely appealed.

STANDARD OF REVIEW

We review a district court's grant of summary judgment de novo. Terry Barr Sales Agency, Inc. v. All-Lock Co., 96 F.3d 174, 178 (6th Cir. 1996). In deciding a summary judgment motion, this court cannot weigh the evidence, judge the credibility of witnesses, or determine the truth of the matter asserted. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986). We view the evidence and draw all "justifiable inferences" in the light most favorable to the non-movant. Id. Summary judgment is appropriate where "there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). "[T]he mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment. . .." Anderson, 477 U.S. at 247-48 (emphasis in original). Mixed questions of law and fact are reviewed de novo. Williams v. Mehra, 186 F.3d 685, 689 (6th Cir. 1999) (en banc).

## ANALYSIS

As the district court correctly noted, in order to prevail on any of the first six counts, Plaintiff must establish that the designation "LawOffices.net" is indeed a valid and legally protectable trademark. See DeGidio v. West Group Corp., No. 3:99 CV 7510, slip op. at 6-7 (N.D. Ohio Mar. 18, 2002) (citing Herman Miller, Inc. v. Palazzetti Imports & Exports, Inc., 270 F.3d 298, 308 (6th Cir. 2001), Am. Online, Inc. v. AT&T Corp., 243 F.3d 812, 819 (4th Cir. 2001); Sunbeam Products Inc. v. The West Bend Co., 123 F.3d 246, 251 (5th Cir. 1997), overruled in part on other grounds sub nom., Traffix Devices, Inc. v. Mktg. Displays Inc., 532 U.S. 23 (2001)) The district court also correctly noted that the Lanham Act offers protection against infringement of both registered and unregistered marks. See, e.g., Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992). To determine whether an unregistered mark is entitled to protection under § 43(a), the courts look to the general principles qualifying a mark for registration under § 2 of the Lanham Act. ETW Corp. v. Jireh Pub., Inc., 332 F.3d 915, 921 (6th Cir. 2003) (citing Two Pesos, 505 U.S. at 768). As this Court has previously indicated, we employ the same analysis to alleged trademark violations under Ohio law, as we do under the federal law. Allard Enters., Inc. v. Advanced Programming Res., Inc., 146 F.3d 350, 354-55 (6th Cir. 1998); Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc., 280 F.3d 619, 626 n. 2 (6th Cir. 2002); Laventhal & Assoc., Inc. v. Thomson Cent. Ohio, 714 N.E.2d 418, 423 (Ohio Ct. App. 1998). Finally, the same federal trademark principles apply to analogous federal and state common law claims. Daddy's Junky Music v. Big Daddy's Family Music, 109 F.3d 275, 288 (6th Cir. 1997).

As the district court observed, "whether Plaintiff's mark qualifies for trademark protection is determined by

where the mark falls along the established spectrum of distinctiveness." DeGidio, No. 3:99 CV 7510, slip op. at 9-10 (citing Boston Beer Co. v. Slesar Bros. Brewing Co., 9 F.3d 175, 180 (1st Cir. 1993)). Putative trademarks may either: (1) be inherently distinctive or (2) acquire distinctiveness through secondary meaning. See Two Pesos, 505 U.S. at 769. Professor McCarthy, in his treatise, further explains that:

> Within the two basic categories are sub-categories that form the complete spectrum of distinctiveness of marks. Arrayed in an ascending order roughly reflecting their eligibility to trademark status and the degree of protection afforded, the categories are: (1) generic terms; (2) descriptive; (3) suggestive; (4) arbitrary or fanciful. Generic terms can never be trademarks, descriptive terms are not inherently distinctive and suggestive, arbitrary and fanciful terms are regarded as being inherently distinctive.

2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:2 (4th ed. 2003). See also Induct-O-Matic Corp. v. Indoctotherm Corp., 747 F.2d 358, 362 (6th Cir. 1984).

In the present case, neither party is arguing that Plaintiff's mark is either generic or arbitrary or fanciful. Because suggestive marks are inherently distinctive, whereas descriptive marks can only acquire distinctiveness through secondary meaning, we first consider into which sub-category, Plaintiff's mark falls.

1. Plaintiff's mark is descriptive

"A suggestive term suggests rather than describes an ingredient or characteristic of the goods and requires the

observer or listener to use imagination and perception to determine the nature of the goods." Induct-O-Matic, 747 F.2d at 362. As this Circuit explained earlier, examples of a suggestive term include "CITIBANK, which connotes an urban or modern bank, or GOLIATH, for wood pencils, connoting a large size." Champions Golf Club, Inc. v. The Champions Golf Club, Inc., 78 F.3d 1111, 1117 (6th Cir. 1996). On the other hand, a trademark is merely descriptive if it describes one, or more, of the following: "the intended purpose, function or use of the goods. . .the class of users of the goods; a desirable characteristic of the goods; or the end effect upon the user." Wynn Oil Co. v. Thomas, 839 F.2d 1183, 1190 (6th Cir. 1988). As the Champions Golf Club court explained, "examples of descriptive marks are BEST, SUPERIOR, and PREFERRED." Champions Golf Club, 78 F.3d at 1117.

The district court found that Plaintiff's mark was, at best, descriptive. DeGidio, No. 3:99 CV 7510, slip op. at 16. To aid in its determination, the court relied on a following six-factor test that was articulated by Professor McCarthy(n10) and accepted by the parties:

> (1) How much imagination on the buyer's part is required in trying to cull a direct message from the mark about the quality, ingredients or characteristics of the product or service? In doing this, it must be kept in mind that the ordinary consumer does not spend much time in the marketplace lingering over such problems. On the other hand, if the potential buying class at issue are experts or professionals, a more critical examination is reasonable.
>
> (2) Does the mark directly convey a real and unequivocal idea of some characteristic, function, quality or ingredient of the product or service to a

reasonably informed potential buyer? That typical buyer will already have some knowledge about the product or service and is neither an expert nor a totally uninformed about the product. Is some reflection or multi-stage reasoning process necessary to cull some direct information about the product from the term used as a mark?

(3) Does the mark so closely tell something about the product or service that other sellers of like products would be likely to want to use the term in connection with their goods? Perhaps a more realistic way to pose this question is to ask whether, without any prior knowledge of this mark, others would be likely to want to use it to describe their products?

(4) Are, in fact, other sellers now using this term to describe their products? Even if the mark is descriptive and has attained secondary meaning, if many others in other product markets are using this term, the mark may be labelled [sic] "weak" and entitled only to narrow protection.

(5) Even though the mark may tell something about the goods or services, is it just as likely to conjure up some other, purely arbitrary connotation? E.g., SUGAR & SPICE baked goods, or POLY PITCHER plastic pitchers.

(6) How does the mark fit into the basic concept that descriptive marks cannot pinpoint one source by identifying and distinguishing only one seller? That is, are buyers likely to regard the mark really as a symbol of origin, or merely as another form of self-laudatory advertising?

2 MCCARTHY § 11:71.

Plaintiff raises a number of arguments challenging the district court's holding. We find them to lack any merit. Ordinarily, we review the district court's classification of a term as "descriptive" or "suggestive" under the clear error standard. See, e.g., Sands, Taylor & Wood Co. v. The Quaker Oats Co., 978 F.2d 947, 952 (7th Cir. 1992); 2 MCCARTHY § 11:3 (citing 1st, 2nd, 3rd, 4th, 5th, 7th, 8th, and Federal Circuits). However, as the Seventh Circuit noted, a grant of a summary judgment motion on the question of whether the mark is descriptive or suggestive, even resolving all factual disputes in favor of a non-moving party, amounts to a legal conclusion. The Quaker Oats Co., 978 F.2d at 952. This legal conclusion is reviewed de novo. Id. See also Eisenmann Corp. v. Sheet Metal Workers Int'l Ass'n Local No. 24, 323 F.3d 375, 380 (6th Cir. 2003).

First, Plaintiff argues that the district court erred when it concluded that "LAWOFFICES was merely descriptive of an online database of attorneys and the electronic publication via a global network of computers" because, according to Plaintiff, there is no "law office that provides a software based service by which the attorney can enter their name, contact information, and specialty, into a database made available to individuals around the world and which is searchable by those users by the attorney's name, state, or specialty." Appellant Br. at 17-18. Plaintiff misses the mark on this argument. When potential clients think of the services that one would obtain from a lawyer in a law office, they certainly envision referrals to specialists, advice on lawyers in other jurisdictions, and other legally-related advice. The fact that Plaintiff (and Defendant) can now provide the same service without a client actually going to a physical office does not change the meaning of the term "law office."(n11)

Second, Plaintiff argues that the district court should have concluded that "LAWOFFICES was suggestive and therefore a trademark for domain name sales (an online searchable database of domain names for sale), website hosting (and third level domain name creation and sales), and the provision of vanity email services." Appellant Br. at 18. Although we find that the district court did not necessarily view evidence in light most favorable to Plaintiff when it applied the six-factor McCarthy test,(n12) we nevertheless uphold the district court's opinion. The district court found that the second factor weighed in favor of Plaintiff. It also found that factors three through six weighed heavily in favor of Defendant. Since the descriptive-suggestive distinction is a continuum, we find that, even if we view the evidence in the light most favorable to Plaintiff, the mark LAWOFFICES lies very close to the descriptive end of a continuum.

Finally, as Defendant points out, the main problem with Plaintiff's position is that Defendant in this case is not even accused of providing those services (i.e. domain name sales, website hosting, and vanity e-mail) on the website that allegedly infringed on Plaintiff's mark.(n13) One can imagine a hypothetical case in which a defendant would provide services identical to Plaintiff's on a LAWOFFICE.COM website. That case would present an interesting question of whether "LAWOFFICES" is a suggestive or a descriptive mark with regard to those services. Since the present controversy does not involve such a fact pattern, we do not address the question of whether "LAWOFFICES" could ever be a suggestive mark.(14)

2. Plaintiff's mark has not acquired secondary meaning.

Since Plaintiff has failed to establish that his mark is suggestive, he must establish that the mark has acquired

secondary meaning in the marketplace. "Secondary meaning is used generally to indicate that a mark or dress has come through use to be uniquely associated with a specific source." Two Pesos, 505 U.S. at 766 n.4 (citations omitted). Plaintiff "must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." Inwood Labs., Inc. v. Ives Labs., 456 U.S. 844, 851 n. 11 (1982). As the district court noted:

> Courts in this Circuit evaluate seven factors to determine whether a mark has acquired secondary meaning: (1) direct consumer testimony; (2) consumer surveys; (3) exclusivity, length and manner of use; (4) amount and manner of advertising; (5) amount of sales and number of customers; (6) established place in the market; and (7) proof of intentional copying. Mktg. Displays, Inc. v. TrafFix Devices, Inc., 200 F.3d 929, 937 (6th Cir. 1999), rev'd on other grounds, 532 U.S. 23 (2001). "[I]t is the party seeking protection of a mark who bears the burden of proving that secondary meaning has attached." Boston Beer Co., 9 F.3d at 182 (citing Bristol-Meyers Squibb Co. v. McNeil-P.P.C., Inc., 973 F.2d 1033, 1041 (2nd Cir. 1992); Blinded Veterans Assoc. v. Blinded Am. Veterans Found., 872 F.2d 1035, 1041 (D.C. Cir. 1989)). "The evidentiary burden necessary to establish secondary meaning is substantial." Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc., 871 F.2d 590, 596 (6th Cir. 1989) Secondary meaning is established when a preponderance of the evidence demonstrates "that the attitude of the consuming public toward the mark denotes 'a single thing coming from a single source.'" Id. at 596 (quoting Aloe Cream Labs. v. Milsan, Inc., 423 F.2d 845, 849 (5th Cir. 1970)). The best evidence of secondary meaning is direct evidence; however, such

evidence is rarely available. See id.; Libbey Glass, Inc. v. Oneida Ltd., 61 F. Supp.2d 700, 707 (N.D. Ohio 1999). Therefore, courts often draw inferences form the above factors. See id.

DeGidio, No. 3:99 CV 7510, slip op. at 17. The district court applied the seven-factor test and found that Plaintiff failed to meet his burden with respect to establishing a secondary meaning for his mark. We agree.

First, with regard to consumer testimony, Plaintiff provided affidavits of three people who visited lawoffices.net website. The affidavits provide no testimony that affiants identify the website with a particular source of services. Mere use of a website does not equal identification with a particular provider. The district court also rejected as irrelevant the rankings by WebsMostLinked.com, a site that ranks websites based upon the number of other sites that link to them. We agree. Second, neither side has provided consumer surveys. Third, the district court found that, even assuming that length and continuity of use is favorable to Plaintiff, the wide use of the phrase "law office(s)" weighed against a finding of secondary meaning. See, e.g., K'Arsan Corp. v. Christian Dior Perfumes, Inc., No. 97-1867, 1998 WL 777987, at *5 (6th Cir. 1998) ("Third-party use of 'sun powder' (by at least two, and as many as five, other companies...) weakens the mark.") (citing Data Concepts Inc. v. Digital Consulting, Inc., 150 F.3d 620, 625 (6th Cir. 1998)); Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 260 (5th Cir. 1980) (finding it significant that there was widespread third-party registration of "Domino"); Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan Ass'n, 651 F.2d 311, 316 (5th Cir. 1981) (finding 4400 businesses using "Sun" in their names to be "impressive evidence that there would be no likelihood of confusion between Sun Banks and Sun Federal.") Fourth, the district court found that Plaintiff's

advertising expenditures of $2,500 over four years is woefully insufficient to establish secondary meaning. See, e.g., Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc., 871 F.2d 590, 596 (6th Cir. 1989) (observing that "extensive advertising which results in consumer association with a single source" is needed to establish secondary meaning and finding that $100,000 in advertising expenses was not enough to establish secondary meaning without further evidence that such advertising was extensive or beyond necessary to survive in the market.) Fifth, the district court credited evidence that Plaintiff in four years generated mere $200 in revenue from banner advertisements and click-through revenues. Burke-Parsons-Bowlby, 871 F.2d at 596 ($2,000,000 in gross sales is insufficient to establish secondary meaning). Sixth, neither side presented evidence regarding Plaintiff's market share. Seventh, Plaintiff failed to establish that Defendant intentionally copied Plaintiff's mark. At most, Plaintiff established that Defendant knew of Plaintiff's website. However, mere knowledge of the competitor's mark is insufficient as a matter of law to prove intentional copying. As the district court noted, "intentional copying...is not actionable under the Lanham Act absent evidence that the copying was done with the intent to derive a benefit from the reputation of another." DeGidio, No. 3:99 CV 7510, slip op. at 23 (citations omitted). Plaintiff's suggestion that Defendant wanted to derive a benefit from his minimal $50 annual business is meritless.

CONCLUSION

In sum, we conclude that Plaintiff's mark is descriptive and that it has not acquired secondary meaning. Accordingly, we affirm the district court's decision.

CONCURRENCE

KAREN NELSON MOORE, Circuit Judge, concurring in part and concurring in the judgment. While I agree with the majority that DeGidio has failed to demonstrate that his mark has inherent or acquired distinctiveness warranting protection under the Lanham Act, I write separately to explain my conclusion that DeGidio's mark is merely descriptive rather than suggestive. I agree with the majority that the district court did not, as is appropriate on summary judgment, necessarily view all of the evidence in the light most favorable to DeGidio. I also agree that the district court's holding was nonetheless correct, but I reach that conclusion by a slightly different route.

We deal in this case with two sets of services: the domain name sales, web site hosting, and email hosting services ("internet services"); and the online attorney database and legal information database services ("database services"). I believe that "LawOffices.net" is clearly descriptive as to the provision of legal information and attorney references. With respect to the internet services, however, I read the factual record differently from the majority, for I believe that West is in fact "accused of" providing web site hosting and vanity email services on its web site. See Appellee's Br. at 7 ("West has also offered . . . e-mail and Web site creation and hosting services."). I think it is therefore necessary to inquire whether "LawOffices.net" is descriptive or suggestive as to those two internet services; although the internet services present a more difficult question, one the district court did not fully address, I nonetheless believe that "LawOffices.net" is descriptive as to these services as well.

While it seems settled that if we were to find that DeGidio had a protectable mark in "LawOffices.net," the difference between the ".net" top-level domain ("TLD")(n1) and the ".com" TLD on West's mark of "Lawoffice.com"

would not matter, see Patent and Trademark Office, "Examination Guide No. 2-99: Marks Composed, in Whole or in Part, of Domain Names" (Sept. 29, 1999), I believe that we can consider the entire mark as used by DeGidio when inquiring as to its distinctiveness. See In re Anylens Acquisition, LLC, Nos. 02-1493, 02-1494, 2003 WL 1194293, at *3 (Fed. Cir. Mar. 10, 2003) (noting a TLD can distinguish a particular type of organization from organizations associated with other TLDs); Virtual Works, Inc. v. Volkswagen of America, Inc., 238 F.3d 264, 271 (4th Cir. 2001) ("vw.net" only "confusingly similar" to "VW"). The TLD ".net" is short for "network," and originally was exclusively for use by network providers.(n2) When DeGidio began LawOffices.net, he specifically chose a ".net" TLD because he planned to offer web site hosting services on his web site. See Joint Appendix at 98-100. I would therefore hold that the mark "LawOffices.net" is descriptive as to the network services that DeGidio offered on his site, namely the web site hosting and vanity email services. See, e.g., Eglen v. America Online, Inc., No. TH 00-135-C-M/H, 2003 WL 21508343, at *9-*10 (S.D. Ind. June 12, 2003) ("hometown.net" is descriptive as to local network service provider's services).

I therefore concur in Part 2 of the majority's opinion and in the judgment.

FOOTNOTES

[1] Although the specific facts of this case involve the designation LawOffices.net, as Plaintiff points out, the ".net" has no trademark significance. Appellant Br. at 11 (quoting The Patent and Trademark Office Examination Guide No. 2-99 (Sept. 29, 1999) (noting that when a trademark "is composed, in whole or in part, of a domain name, neither the

beginning of the [Uniform Resource Locator] (http://www.) nor the TLD [top-level domain] have any source indicating significance. Instead, those designations are merely devices that every Internet site provider must use as part of its address.") So Plaintiff is really seeking to trademark LAWOFFICES. This would affect those practitioners who have and who will seek to set up their practice as "Law Office[s] of [Individual's Name.]"

[2] Plaintiff registered the domain name on January 25, 1996 and began the creation of the website in February of 1996.

[3] Vanity e-mail is a service whereby an individual could obtain an e-mail address with "@lawoffices.net" after the individual's name (e.g. smith@lawoffices.net).

[4] Domain names is a service whereby a person can set up a website with ".lawoffices.net" at the end (e.g. smith.lawoffices.net).

[5] The essential features of Plaintiff's putative trademark are: (1) a capitalization of "l" and "o;" (2) pluralization of "lawoffice;" and (3) placement of the term "LawOffice.net" in black font in a horizontal rectangular box that is shaded in marbled white and light gray.

[6] The essential features of Defendant's designation are: (1) captialization of the letter "l" only; (2) singular, as opposed to plural, "lawoffice;" (3) italicization of "law;" (4) placement of Lawoffice.com in white font in a dark blue rectangular box; (5) a multi-colored open door emblem situated over the "dot;" and (6) the text "from West Legal Directory" place in smaller white font beneath Lawoffice.

[7] Visitors to lawoffice.com are redirected to a Findlaw directory page at http://directory.findlaw.com.

[8] The website offers information on over four hundred legal topics, a directory of approximately 1 million attorneys and other legal professionals, an online searchable legal dictionary, and a frequently asked questions section. West also offers fee-based services, such as e-mail, website creation and hosting, and sponsorship packages. None of the fee-based services, however, are advertised at the Lawoffice.com website.

[9] As the district court noted, Plaintiff has withdrawn Count II because in order to sustain a cause of action in Count II, a plaintiff must own a registered trademark, OHIO REV. CODE ANN. § 1329.66, and Plaintiff in the present case does not.

[10] Professor McCarthy developed the test to assist lawyers and judges in distinguishing between descriptive and suggestive marks because "the descriptive-suggestive dichotomy [is not] some kind of concrete and objective classification system. It is no more objective and free of personal predilections that a test which asks persons to divide all color shades into 'light' and 'dark.'" 2 MCCARTHY § 11:71.

[11] Plaintiff in his reply brief takes "issue with the finding that one typically would find a law office which provides to the public the service of searching for other attorneys or a service that publishes law articles and decisions to the public." This statement is baffling because, to the best of this Court's knowledge, attorneys routinely provide references to other attorneys, as well as provide their clients with copies of relevant law articles and court decisions. The fact that Plaintiff chooses not to charge the

public for the provision of these services may make him a good person, but it does not entitle him to trademark protection.

[12] With regard to the first factor, the district court noted that "there is not a high degree of imagination that a typical buyer must employ to imagine the nature of Plaintiff's services, particularly in light of the sophistication level of the attorneys and other consumers likely to utilize such a website." DeGidio, No. 3:99 CV 7510, slip op. at 14. Had the district court found that after conducting a trial, we would not disturb that finding. We are troubled, however, by this conclusion at a summary judgment stage.

[13] As Defendant points out in its brief, "a retailer may not claim the word "Bicycle Shop" as a trademark for his bicycle store because he also sells soft drinks and candy under the "Bicycle Shop" brand. Because West does not list domain names for sale under its Lawoffice.com mark, it does not infringe any supposed protectable element of DeGidio's designation." Appellee Br. at 17 n. 10.

[14] Plaintiff in his reply brief argues that "West's claims that there is no infringement were not addressed by the Trial Court because it found no mark rights. Any arguments as to infringement are not yet ripe for review and cannot be analyzed until one knows what services have been trademarked." Appellant Reply Brief at 3. We disagree. As stated above, our problem with Plaintiff's case is not the question of whether services have been trademarked, but a more limited problem that there is nothing in the record to support the claim that Defendant did any of the things that, assuming Plaintiff has a trademark, would amount to an infringement.

[1] Each website has a corresponding domain name, which is an identifier somewhat analogous to a telephone number or street address. Domain names consist of a second-level domain — simply a term or series of terms (e.g., a2zsolutions) — followed by a top-level domain, many of which describe the nature of the enterprise. Top-level domains include ".com" (commercial), ".edu" (educational), ".org" (non-profit and miscellaneous organizations), ".gov" (government), ".net" (networking provider), and ".mil" (military).

Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc., 326 F.3d 687, 691 (6th Cir. 2003) (citations omitted).

[2] Originally, the TLD ".net" was only available to network service providers, but according to one circuit, it was in September 1995 that the organization in charge of assigning TLDs stopped enforcing these distinctions. See Virtual Works, Inc. v. Volkswagen of America, Inc., 238 F.3d 264, 266 (4th Cir. 2001). DeGidio claimed in his deposition testimony that ".net" was still restricted when he registered "LawOffices.net." If DeGidio is better informed than our sister circuit as to the precise date when ".net" ceased to be a restrictive TLD, it can only hurt his case that his mark is not descriptive.

Case No. 3:99 CV 7510

IN THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF OHIO, WESTERN DIVISION

ANTHONY J. DEGIDIO,
Plaintiff,

v.

WEST GROUP CORP., et al.,
Defendants.

March 18, 2002, Filed

COUNSEL: For Anthony J. DeGidio, Plaintiff: Anthony J. DeGidio, Calamunci, Groth & Joelson, Toledo, OH.

For West Group Corporation, Thomson Corporation, The, West Licensing Corporation, Defendants: Carol Witschel, Jennifer L. Johnson, Robert L. Raskopf, Shannon M. Hudnall, White & Case, New York, NY.

For West Group Corporation, Thomson Corporation, The, West Licensing Corporation, Defendants: Richard M Kerger, Kerger & Kerger, Toledo, OH.

JUDGES: DAVID A. KATZ, U. S. DISTRICT JUDGE.

OPINIONBY: DAVID A. KATZ

OPINION:
MEMORANDUM OPINION

KATZ, J.

Pending before this Court are cross-motions for summary judgment filed by Defendants, West Group Corporation, The Thompson Corporation, and West Licensing Corporation ("Defendants" or "West"), and Plaintiff Anthony DeGidio ("DeGidio"), who is proceeding pro se in the above-captioned matter. Jurisdiction in this Court is proper pursuant to 28 U.S.C. § § 1331, 1332, and 1338(a). Based upon careful consideration of the parties' respective motions, oppositions, and replies, and the entire record herein, the Court will grant in part and deny in part Defendants' Motion for Summary Judgment (Doc. No. 50). The Court will deny Plaintiff's Motion for Summary Judgment (Doc. No. 55) in its entirety.

I. BACKGROUND

Plaintiff is the registrant of the domain name "lawoffices.net" and alleged founder and owner of the corresponding website, which provides an attorney directory, legal information relating to cyberlaw issues, a vanity email service, listings of domain names for sale, and a hosting service for legal related websites. In the instant action, Plaintiff asserts trademark protection for the designation LawOffices.net, n1 which is the moniker attached to the website lawoffices.net. However, Plaintiff does not own either a federal or state registration for the LawOffices.net designation. The essential features of Plaintiff's putative trademark are: (1) a capitalization of the letters "l" and "o;" (2) pluralization of "lawoffice;" and (3) placement of the term "LawOffices.net" in black font in a horizontal rectangular box that is shaded in marbled white and light gray. n2

Defendants utilize the designation Lawoffice.com and the domain name "lawoffice.com" n3 to market the West Legal Directory, described by Defendants as "a 'one-stop' online

resource for useful information pertaining to law and lawyers for businesses, professional and consumers." Defs.' Mot. Summ. J. at 5. Defendants' website offers information on over four hundred legal topics, a directory of attorneys and other legal professionals, an online searchable legal dictionary, and a frequently asked questions section. See id. at 5-6. In addition to the aforementioned services, West also offers fee-based services, including email, website creation and hosting, and sponsorship packages. See id. However, these fee-based services are not advertised at the Lawoffice.com website. See id. The essential features of the designation Lawoffice.com are: (1) capitalization of the letter "1;" (2) singular, as opposed to plural, "lawoffice;" (3) italicization of "law;" (4) placement of Lawoffice.com in white font in a dark blue rectangular box; (5) a multi-colored open door emblem situated over the "dot;" and (6) the text "from West Legal Directory" placed in smaller white font beneath Lawoffice.

Plaintiff asserts that Defendants' use of the designation Lawoffice.com in conjunction with the website lawoffice.com infringes upon his alleged rights in the designation LawOffices.net and the affiliated lawoffices.net website. Specifically, Plaintiff pleads seven causes of action, alleging: (1) violations of the Ohio Deceptive Trade Practices Act, OHIO REV. CODE ANN. § § 4165.01-4165.04 (Anderson 1998 & Supp. 2000); (2) unauthorized use of a trademark pursuant to OHIOREV. CODE ANN. § 1329.65 (Anderson 1993 & Supp. 2000); n5 (3) common law unfair competition; (4) false designation of origin pursuant to 15 U.S.C. § 1125(a); (5) trademark dilution pursuant to 15 U.S.C. § 1125(c); (6) common law dilution; and (7) common law misappropriation.

Defendants have moved for summary judgment, asserting inter alia that the "designation LawOffices.net is descriptive,

devoid of secondary meaning, and therefore not entitled to trademark protection." Defs.' Mem. P. & A. at 1. Defendants also argue that even if this Court determines that there is a genuine factual dispute as to the trademark status of the designation of LawOffices.net, Plaintiff still cannot prevail on his dilution claims because he cannot establish that his mark is famous. Defendants further assert that Plaintiff cannot maintain his Ohio state law claims because he does not own an Ohio registration for the LawOffices.net designation.

Plaintiff not only opposes Defendants' motion, but also has moved for summary judgment on Counts I-IV; however, Plaintiff maintains that there are "serious factual disputes regarding the fifth through seventh claims and they are thus inappropriate for summary judgment." Pl.'s Mot. Summ. J. at 6.

## II. DISCUSSION

### A. Summary Judgment Standard

"Summary judgment is just as appropriate in a trademark infringement case as in other litigation and is granted or denied on the same principles." Freed v. Farag, 994 F. Supp. 887, 889 (N.D. Ohio 1997) (citing WSM, Inc. v. Tenn. Sales Co., 709 F.2d 1084, 1086 (6th Cir.1983); SCI Sys, Inc. v. Solidstate Controls, Inc., 748 F. Supp. 1257, 1260 (S.D. Ohio 1990)). Summary judgment must be entered "against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." Celotex Corp. v. Catrett, 477 U.S. 317, 322, 106 S. Ct. 2548, 2552, 91 L. Ed. 2d 265 (1986). Of course, the moving party always bears the initial responsibility of informing the district court of the basis for its motion, and identifying those portions of "the pleadings, depositions, answers to

interrogatories, and admissions on file, together with the affidavits, if any," which it believes demonstrate the absence of a genuine issue of material fact. Id. at 323, 106 S. Ct. at 2553. The burden then shifts to the nonmoving party who "must set forth specific facts showing that there is a genuine issue for trial." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250, 106 S. Ct. 2505, 2511, 91 L. Ed. 2d 202 (1986) (quoting FED. R. CIV. P. 56(e)).

Once the burden of production has so shifted, the party opposing summary judgment cannot rest on its pleadings or merely reassert its previous allegations. It is not sufficient "simply [to] show that there is some metaphysical doubt as to the material facts." Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586, 106 S. Ct. 1348, 1356, 89 L. Ed. 2d 538 (1986). Rather, Rule 56(e) "requires the nonmoving party to go beyond the [unverified] pleadings" and present some type of evidentiary material in support of its position. Celotex, 477 U.S. at 324, 106 S. Ct. at 2553; see also Harris v. GMC, 201 F.3d 800, 802 (6th Cir. 2000). Summary judgment shall be rendered if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." FED. R. CIV. P. 56(c).

"In considering a motion for summary judgment, the Court must view the facts and draw all reasonable inferences therefrom in a light most favorable to the nonmoving party." Williams v. Belknap, 154 F. Supp. 2d 1069, 1071 (E.D. Mich. 2001) (citing 60 Ivy Street Corp. v. Alexander, 822 F.2d 1432, 1435 (6th Cir. 1987)). "The Court is not required or permitted, however, to judge the evidence or make findings of fact." Id. The purpose of summary judgment "is not to resolve factual issues, but to determine if there are

genuine issues of fact to be tried." Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc., 130 F. Supp. 2d 928, 930 (S.D. Ohio 1999). Ultimately, this Court must determine "whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law." Anderson, 477 U.S. at 251-52; see also Atchley v. RK Co., 224 F.3d 537, 539 (6th Cir. 2000).

B. Overview of Plaintiff's Claims

As a preliminary matter, Defendants assert, and Plaintiff does not contest, that in order to prevail on any of his claims, Plaintiff must first establish that the designation LawOffices.net is indeed a valid and legally protectable trademark. The Court agrees with this assertion, at least with respect to Counts I-VI, and thus begins its analysis of these claims with an inquiry as to the validity of Plaintiff's designation. See Herman Miller, Inc. v. Palazzetti Imports & Exports, Inc., 270 F.3d 298, 308 (6th Cir. 2001); Am. Online, Inc. v. AT&T Corp., 243 F.3d 812, 819 (4th Cir. 2001) (explaining that plaintiff asserting rights to unregistered mark carries the burden of establishing "that it has a valid, protectable trademark and that the defendant is infringing its mark"); Sunbeam Products Inc. v. The West Bend Co., 123 F 3d 246, 251 (5th Cir. 1997), overruled in part on other grounds by Traffix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 149 L. Ed. 2d 164, 121 S. Ct. 1255 (2001); 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27:14 at 27-27 (4th ed. 2001). As discussed below, these claims are analyzed pursuant to federal trademark principles.

As to Count VII, common law misappropriation, Defendants argue that the Court should analyze this claim as an unfair competition claim. However, Plaintiff does not premise this

claim upon the alleged infringement of his putative common law trademark. Instead, Plaintiff asserts a claim for misappropriation of the "trade value" of the lawoffices.net designation and website. Therefore, the Court disagrees with Defendants' assertion that this claim is subject to the trademark analysis applicable to Plaintiff's other claims. As indicated supra note 5, Plaintiff has withdrawn Count II and the Court does not undertake an analysis of this claim. However, given the procedural oddity created by Plaintiff's failure to formally amend his complaint to withdraw this cause of action, the Court makes clear that Defendants are entitled to summary judgement on this count. In order to sustain his cause of action in Count II, Plaintiff must own a registered trademark, see OHIO REV. CODE ANN. § 1329.66, and Plaintiff has not fulfilled this requirement.

C. Counts I-VI

Defendants assert that Plaintiff's mark is not entitled to protection, in part because Plaintiff does not own either a federal or Ohio state registration for his mark. Plaintiff counters that "the Lanham Act offers protection against infringement of registered and unregistered marks." Pl.'s Mot. Summ. J. at 7 (citing Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768, 112 S. Ct. 2753, 120 L. Ed. 2d 615 (1992)). Plaintiff further asserts that unregistered marks qualify for protection under Ohio statutory and common law because courts analyze those claims under analogous federal principles, which provide protection for qualifying unregistered marks. Defendants also assert that Plaintiff's mark is not protectable because it is classified as "descriptive" and has not acquired the secondary meaning required to confer trademark protection. Plaintiff asserts that his mark is "suggestive" rather than "descriptive," but alternatively argues that should the Court find that the mark

is descriptive, it has acquired the secondary meaning necessary to confer trademark protection.

As discussed below, Plaintiff is correct in his assertions as to the protectability of unregistered marks. The Lanham Act, as well as Ohio statutory and common law, provide trademark protection for certain unregistered marks. However, that does not resolve the issue of whether Plaintiff owns a valid and legally protectable unregistered designation. In order for a mark to benefit from trademark protection, it must be of a type that is entitled to protection. As discussed below, the Court determines that Plaintiff's mark is not entitled to protection because it is descriptive and devoid of secondary meaning.

1. Unregistered marks are eligible for trademark protection

While federal registration generally confers a presumption of trademark validity, see Burke-Parsons-Bowlby v. Appalachian Log Homes, 871 F.2d 590, 593 (6th Cir. 1989), it is nonetheless "settled that § 43(a) of the Lanham Act protects qualifying unregistered marks, and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are generally applicable in determining whether an unregistered mark is entitled to protection under § 43(a)." n6 Boston Beer Co. Ltd. P'ship v. Slesar Bros. Brewing Co., 9 F.3d 175, 180 (1st Cir. 1993) (citing Two Pesos, 505 U.S. at 768).

In analyzing trademark claims alleged under Ohio law, courts employ the same analysis as when considering analogous federal claims. See Allard Enters., Inc. v. Advanced Programming Res., Inc., 146 F.3d 350, 354-55 (6th Cir. 1998); Worthington Foods, Inc. v. Kellogg Co., 732 F. Supp. 1417, 1431 (S.D. Ohio 1990) (explaining that "an analysis appropriate for a determination of liability under

section 43(a) of the Lanham Act is also appropriate for determining liability under the Ohio Deceptive Trade Practices Act"). Federal trademark principles are applied as well to analogous common law claims. See Daddy's Junky Music v. Big Daddy's Family Music, 109 F.3d 275, 288 (6th Cir. 1997); Worthington Foods, 732 F. Supp. at 1431. Based upon these principles, Ohio courts have acknowledged that qualifying unregistered marks are eligible for state statutory and common law protection. Therefore, the fact that Plaintiff has not registered his mark does not preclude the mark from qualifying as a protectable trademark. However, whether Plaintiff's mark qualifies for trademark protection is determined by where the mark falls along the established spectrum of distinctiveness. Boston Beer Co., 9 F.3d at 180 (explaining that "[a] court's inquiry into whether a term merits trademark protection starts with the classification of that term along the spectrum of 'distinctiveness'").

2. Classification of Plaintiff's mark

a. Categories of trademark classification

There are two basic categories into which putative trademarks fall: (1) those that are inherently distinctive, and (2) those that have acquired distinctiveness through secondary meaning. n7 See Two Pesos, 505 U.S. at 769. As explained by Professor McCarthy:

Within the two basic categories are sub-categories that form the complete spectrum of distinctiveness of marks. Arrayed in an ascending order roughly reflecting their eligibility to trademark status and the degree of protection afforded, the categories are: (1) generic terms; (2) descriptive; (3) suggestive; (4) arbitrary or fanciful. Generic terms can never be trademarks, descriptive terms are not inherently

distinctive and suggestive, arbitrary and fanciful terms are regarded as being inherently distinctive.

2 MCCARTHY § 11:2.

"A generic term is . . . used to commonly describe the relevant type of goods or services." Champions Golf Club, Inc. v. The Champions Golf Club, Inc., 78 F.3d 1111, 1117 (6th Cir. 1996). Terms that are generic, such as "aspirin" or "light beer," are the weakest type mark and are not entitled to any trademark protection. See id. Marks that are arbitrary or fanciful are entitled to the highest degree of trademark protection. As explained in Homeowners Group, Inc. v. Home Marketing Specialists, Inc.:

"An 'arbitrary' mark has a significance recognized in everyday life, but the thing it normally signifies is unrelated to the product or service to which the mark is attached," such as CAMEL cigarettes or APPLE computers. Id. "A 'fanciful' mark is a combination of letters or other symbols signifying nothing other than the product or service to which the mark has been assigned," such as EXXON or KODAK. Id..

931 F.2d 1100, 1107 (6th Cir. 1996) (quoting Little Caesar Enters., Inc. v. Pizza Caesar, Inc., 834 F.2d 568, 571 (6th Cir. 1987)).

In the instant action, the parties do not argue that Plaintiff's mark is either generic, or arbitrary or fanciful, and it is clear from the established definition of these classifications that Plaintiff's mark does not fall within these categories. The crux of the parties' dispute is whether Plaintiff's mark is descriptive or suggestive.

"A suggestive term suggests rather than describes an ingredient or characteristic of the goods and requires the

observer to use imagination and perception to determine the nature of the goods." Worthington Foods, 732 F. Supp. at 1433 (quotation and citation omitted). "Examples are CITIBANK, which connotes an urban or modern bank, or GOLIATH, for wood pencils, connoting a large size." Homeowners, 931 F.2d at 1107. "A suggestive term is considered stronger than one that is merely descriptive, and does not require proof of secondary meaning." Id.

"A trademark is descriptive 'if it describes: the intended purpose, function or use of the goods; the size of the goods; the class of users of the goods; a desirable characteristic of the goods; or the end effect upon the user.'" Worthington Foods, 732 F. Supp. at 1433 (quoting Wynn Oil. Co. v. Thomas, 839 F.2d 1183, 1190 (6th Cir. 1988)). If a mark directly conveys information about the "characteristics, functions, or qualitites" of the product or service to which it is attached, then the mark is descriptive. Id. "Examples of descriptive marks are BEST, SUPERIOR, and PREFERRED." Homeowners, 931 F.2d at 1107; see also Washington Speakers Bureau, Inc. v. Leading Authorities, Inc. 33 F. Supp. 2d 488, 494 (E.D. Va. 1999) (giving examples of "'After Tan' post-tanning lotion, '5 Minute' glue, and the 'Yellow Pages' telephone directory"). A mark "cannot escape from the descriptive category simply because it does not bring to mind any one product when scrutinized in the abstract." 732 F. Supp. at 1434. A descriptive mark may be entitled to protection only if it has acquired secondary meaning, i.e., if it has come to distinctively identify the source of a particular good or service, as opposed to merely identifying the product or service itself. See id.

b. The descriptive-suggestive distinction

Defendants submit that Plaintiff's mark is at best descriptive, but nonetheless not entitled to protection because it is devoid of secondary meaning. Plaintiff counters that his mark is properly categorized as suggestive, therefore eliminating the need for a showing of secondary meaning. Alternatively, Plaintiff asserts that his mark, if distinctive, has acquired the requisite secondary meaning.

Defendants submit that LawOffices.net "is merely descriptive because it is not inherently distinctive and merely describes the intended function of the services he provides, i.e., legal services and information for lawyers and persons looking for lawyers or legal services." Defs.' Mem. P. & A. at 9. Plaintiff counters that his mark would be descriptive "if used to refer solely to a service which consisted of law offices," Pl.'s Mot. Summ. J. at 10, but argues that his designation is suggestive, because "no reasonable person could automatically reach the conclusion that a website named lawoffices.net included vanity email services, web hosting, domain name law, a directory of domain names for sale and a public access database of attorneys." Id. at 10-11. Plaintiff argues that LawOffices.net must be regarded as suggestive because "some imagination or perception of the site is required to understand the service's full nature." Id.

Realistically, Plaintiff's mark has characteristics of both classifications. The mark certainly has a descriptive element to it, as LawOffices.net conveys the message that the services provided by Plaintiff are those that one typically would find in a law office, or through a network of law offices, such as an attorney directory and topical legal advice. On the other hand, LawOffices.net is ostensibly suggestive, at least insofar as related to the domain name sales, website hosting, and vanity email service. Often there is a fine line between suggestive and descriptive marks, and Plaintiff's mark appears to fall within the area of ambiguity

between the two classifications. To properly classify Plaintiff's mark, the Court gleans guidance from six factors compiled by Professor McCarthy, and used by other courts, for distinguishing between suggestive and descriptive marks. See, e.g., Worthington Foods, 732 F. Supp. at 1435. These factors are:

(1) How much imagination on the buyer's part is required in trying to cull a direct message about the quality, ingredients or characteristics of the product or service? It must be kept in mind that the ordinary consumer does not spend much time in the marketplace lingering over such problems. On the other hand, if the potential buying class at issue are experts or professionals, a more critical examination is reasonable.
(2) Does the mark directly convey a real and unequivocal idea of some characteristic, function, quality or ingredient of the product or service to a reasonably informed buyer? . . . Is some reflection or multi-stage reasoning process necessary to cull direct information about the product from the term used as a mark?
(3) Does the mark so closely tell something about the product or service that other sellers of like product would be likely to want to use the term in connection with their goods? Without any prior knowledge of this mark, [would] others . . . be likely to want to use it to describe their products?
(4) Are . . . other sellers now using this term to describe their products? Even if the mark is descriptive and has attained secondary meaning, if many others in other product markets are using this term, the mark may be labelled "weak" and entitled only to narrow protection.
(5) Even though the mark may tell something about the goods or services, is it just as likely to conjure up some other, purely arbitrary connotation? E.g., SUGAR & SPICE baked goods, or POLY PITCHER plastic pitchers.
(6) How does the mark fit into the basic concept that descriptive marks cannot pinpoint one source by identifying

and distinguishing only one seller? That is, are buyers likely to regard the mark really as a symbol of origin, or merely as another form of self-laudatory advertising?

2 MCCARTHY § 11:71. Professor McCarthy cautions that "a term that is in one category for a particular product may be in a quite different category for another product." Id. Professor McCarthy also advises that "the proper categorization will vary with the relationship between the term and the product or services." Id.

In regard to the first factor, there is not a high degree of imagination that a typical buyer must employ to imagine the nature of Plaintiff's services, particularly in light of the sophistication level of the attorneys and other consumers likely to utilize such a website. Although Plaintiff asserts that vanity email services, website hosting, domain name sales, and a searchable public access database are not features that are readily apparent to most users, it does not require a vast cognitive leap to imagine that Plaintiff would provide such services, given that the very type of practice in which Plaintiff is engaged, cyberlaw and intellectual property, is closely related to these services. Therefore, the Court finds that the first factor weighs, albeit only slightly, in favor of classification as a descriptive mark. However, the Court does find that in regard to factor two, it would require of most consumers a multi-staged reasoning process "to cull some direct information" about Plaintiff's services. Even a sophisticated buyer, while readily associating LawOffices.net with Plaintiff's legal services, might not readily associate LawOffices.net with the provision of vanity email addresses and information related to domain name sales. When encountering the designation LawOffices.net, one would likely first consider the types of services provided by a typical law office, such as legal services, attorney referrals, and topical legal advice. Only upon reflection of

Plaintiff's specific practice is one likely to arrive at the conclusion that Plaintiff also provides vanity email and webhosting. Therefore, the Court finds that the second factor weighs in favor of classification as a suggestive mark.

In regard to the third factor, the Court need not speculate as to whether "others would be likely to want to use [the mark] to describe their [own] products," 2 MCCARTHY § 11:71, because others obviously have utilized permutations of LawOffices.net in order to represent their own suite of legal services. n8 As to factor four, the wide third-party use of similar marks suggests that Plaintiff's mark is "'weak' and entitled only to narrow protection." 2 MCCARTHY § 11:71. Therefore, the Court finds that the third and fourth factors weigh in favor of classification as a descriptive mark.

With respect to the fifth factor, Plaintiff does not submit that his mark is likely to "conjure up some other, purely arbitrary connotation," 2 MCCARTHY § 11:71, and the Court does not find that the designation LawOffices.net suggests anything arbitrarily unrelated to Plaintiff's services. As noted above, even if most law offices do not arguably offer a vanity email service and information on domain name sales, the instant balancing test is to be applied in light of the "relationship between the term and the product or services." Id. Given that Plaintiff's practice is focused on cyberlaw and intellectual property issues, it is not arbitrary for one to draw an association between LawOffices.net and the email and domain name services, in the particular context in which the mark is used. Therefore, the Court finds that the fifth factor weighs in favor of classification as a descriptive mark.

As to the sixth factor, the Court concludes that potential customers are not likely to view Plaintiff's mark as a distinctive symbol of origin, as is evidenced by the wide third-party use of similar marks. Even assuming that

Plaintiff's mark is distinctive enough to compel some consumers to associate LawOffices.net only with his services as opposed to the multitude of other legal professionals offering similar services using similar designations, the Court nonetheless finds that the above factors in toto weigh in favor of classification of Plaintiff's mark as descriptive, as opposed suggestive.

In sum, Plaintiff's mark is at best descriptive, and entitled to protection only if Plaintiff can establish that the mark has acquired secondary meaning in the marketplace.

3. Secondary meaning

"Secondary meaning is used generally to indicate that a mark or dress 'has come through use to be uniquely associated with a specific source.'" Two Pesos, 505 U.S. at 766 n.4. To establish secondary meaning, Plaintiff "must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." Inwood Labs., Inc. v. Ives Labs., 456 U.S. 844, 851 n.11, 102 S. Ct. 2182, 72 L. Ed. 2d 606 (1982). "To acquire secondary meaning in the minds of the buying public, an article of merchandise when shown to a prospective customer must prompt the affirmation, 'That is the article I want because I know its source[.]' The article must proclaim its identification with its source, and not simply stimulate inquiry about it." Herman Miller, 270 F.3d at 311.

Courts in this Circuit evaluate seven factors to determine whether a mark has acquired secondary meaning: (1) direct consumer testimony; (2) consumer surveys; (3) exclusivity, length, and manner of use; (4) amount and manner of advertising; (5) amount of sales and number of customers; (6) established place in the market; and (7) proof of

intentional copying. Mktg. Displays, Inc. v. TrafFix Devices, Inc., 200 F.3d 929, 937 (6th Cir. 1999), rev'd on other grounds 532 U.S. 23, 149 L. Ed. 2d 164, 121 S. Ct. 1255 (2001). "It is the party seeking protection of a mark who bears the burden of proving that secondary meaning has attached." Boston Beer Co., 9 F.3d at 182 (citing Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc., 973 F.2d 1033, 1041 (2d Cir. 1992); Blinded Veterans Assoc. v. Blinded Am. Veterans Found., 257 U.S. App. D.C. 65, 872 F.2d 1035, 1041 (D.C. Cir. 1989)). n9 "The evidentiary burden necessary to establish secondary meaning is substantial." Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc., 871 F.2d 590, 596 (6th Cir. 1989). Secondary meaning is established when a preponderance of the evidence demonstrates "that the attitude of the consuming public toward the mark denotes 'a single thing coming from a single source.'" Id. at 596 (quoting Aloe Cream Labs. v. Milsan, Inc., 423 F.2d 845, 849 (5th Cir. 1970)). The best evidence of secondary meaning is direct evidence; however, such evidence rarely is available. See id.; Libbey Glass, Inc. v. Oneida Ltd., 61 F. Supp. 2d 700, 707 (N.D. Ohio 1999). Therefore, courts often draw inferences from the above factors. See id.

i. Consumer testimony

In regard to consumer testimony, Plaintiff has provided the Court with the affidavits of three people who have visited the lawoffices.net website. See Pl.'s Mot. Summ. J. Ex. 8-10. The affiants all state that they have visited the lawoffices.net webite and that all noticed Plaintiff's putative mark on the website during their respective visits. One affiant utilized the attorney database. Another affiant subscribed to Plaintiff's vanity email service and testifies that he finds the service useful. After visiting Plaintiff's website, the third affiant sought to exchange website links. Notably, Plaintiff

does not offer testimony from a single customer who states that he associates LawOffices.net solely with Plaintiff or that he visited the lawoffices.net website because he identified the moniker with a particular source of services. Admittedly, "direct consumer testimony 'need not take the form of explicit testimony from consumers stating that 'I care that X produced this product.'" Herman Miller, 270 F.3d at 312 (quoting Thomas & Betts Corp. v. Panduit Corp., 138 F.3d 277, 294 (7th Cir. 1998)). However, the Court does not equate a declaration of use, or even utility of the Plaintiff's website and services, with LawOffices.net having become associated with a single, particular source. To buttress his position, Plaintiff offers statistics indicating the ranking of the lawoffices.net website on particular search engines. However, Plaintiff fails to explain how such information indicates that consumers associate the designation LawOffices.net with a single source of services.

ii. Consumer surveys

Survey results "are 'considered the most direct and persuasive' evidence of secondary meaning." Libbey Glass, 61 F. Supp. 2d at 707. Unfortunately, the parties have not offered survey evidence to support their motions.

iii. Exclusivity, length, and manner of use

In mistaken reliance upon a Supreme Court case addressing the 15 U.S.C. § 1052(f) n10 statutory presumption of distinctiveness that accrues after five years of exclusive and continuous use, Plaintiff asserts that he "has been using the mark since 1996 so the third factor would weigh in his favor." Pl.'s Mot. Summ. J. at 14 (citing Park ' N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 83 L. Ed. 2d 582, 105 S. Ct. 658 (1985)). This presumption is of no benefit to Plaintiff because the five year time period is measured from

"the date on which the claim of distinctiveness is made," and the owner of a descriptive mark must demonstrate that the mark acquired secondary before its first use by alleged infringer. Burke, 871 F.2d at 596; see also Ashland Oil, Inc. v. Olymco, Inc., 64 F.3d 662, 1995 WL 499466, at *1 (6th Cir. 1995) (affirming decision in which district court assessed date of claim of distinctiveness as arising from defendant's first use). When West launched its website in June 1999, Plaintiff had used his mark for only three years. Duration of use must be of "more than a relatively short period" to establish secondary meaning. Burke, 871 F.2d at 597 (noting that three years has been determined as insufficient to establish secondary meaning).

Moreover, while Plaintiff addresses the length of use element, he does not adequately address the other two elements in this prong of the test, i.e., exclusivity and continuity of use. In regard to continuity of use, Defendants note certain time periods when the lawoffices.net website was inoperable. However, the Court not does accord much weight to this argument and does not take issue with Plaintiff's assertion that he has used the designation LawOffices.net continuously since 1996.

Regarding exclusivity of use, Defendants assert that the wide third party use of domain names and designations including the phrase "law office(s)" weighs against a finding of secondary meaning. Both sides have submitted information, including telephone directory listings and website search engine results, indicating that there are numerous organizations and websites utilizing the term "lawoffice" to represent their business. The wide-spread third-party use, coupled with the short duration of use by Plaintiff, weighs against a finding for Plaintiff on this factor. See Echo Travel, Inc. v. Travel Associates, Inc., 870 F.2d 1264, 1269 (7th Cir. 1989) (" third party use of a substantially similar

mark to promote the same goods or services to the same consumer class weighs against a finding that the consumer class associates the mark with one source").

iv. Amount and manner of advertising

Plaintiff has spent $ 2,500 over four years to advertise and promote his website. Defendants argue that Plaintiff's advertising expenditures are limited in regard to both dollar amount and scope. In support of their position, Defendants maintain that Plaintiff "has not engaged in direct mail, print, radio or television advertising of the LawOffices.net Web site." Defs.' Mem. P. & A. at 4.

"Advertising and sales volume, while relevant, are not sufficient, without more, to establish secondary meaning." Libbey Glass, 61 F. Supp. 2d at 708 (citing Burke, 871 F.2d at 596). "Where advertising expenditures are required to 'merely survive' in the competitive market, advertising expenditures cannot be used to prove secondary meaning." Burke, 871 F.2d at 596. While Plaintiff has spent $ 2,500 on advertising, he does not establish that these expenditures are extensive, nor that the expenditures are beyond that necessary for market survival. See id. (only "extensive advertising which results in consumer association with a single source" established secondary meaning). Plaintiff nonetheless asserts that he "has shown extensive recognition in internet search engines and other ranking sites." Pl.'s Mot. Summ. J. at 14. However, Plaintiff does not explain how this information is relevant to establishing that customers associate LawOffices.net with a single source of services. See Shade's Landing, Inc. v. Williams, 76 F. Supp. 2d 983, 989-90 (D. Minn. 1999) (rejecting "high placement of plaintiff's web site in search engine listings" as evidence that consumers associated plaintiff's services with plaintiff's mark).

v. Amount of sales and number of customers

Defendants submit that Plaintiff has earned no revenue from services he provides through his website, that he has never had a paying customer, has never had any employees, and has earned less that $ 200 in revenue from banner advertisements and click-through revenues. Plaintiff offers the affidavits from three people who have accessed the lawoffices.net website, but provides no further evidence of a customer base. Moreover, Plaintiff provides no evidence that the arguably paltry commissions generated from banner ads is sufficient to establish secondary meaning. See, e.g., Burke, 871 F.2d at 596 (finding $ 2,000,000 in gross sales as insufficient to establish secondary meaning).

vi. Established place in the market

Regarding factor six, Plaintiff's established place in the market, the parties have presented no evidence on Plaintiff's market share. Plaintiff merely asserts that "his place in the internet marketplace is more established." Pl.'s Mot. Summ. J. at 14. Plaintiff provides no evidence to this effect, beyond the ranking of lawoffices.net in certain internet search engine listings, which is irrelevant to the instant inquiry.

vii. Proof of intentional copying

Courts have presumed secondary meaning in instances where a defendant intentionally, and often admittedly, copied a plaintiff's mark or trade dress. See, e.g., Ferrari v. Roberts, 944 F.2d 1235, 1239 (6th Cir. 1991) (defendant admitted to intentionally copying Ferrari design); McNeil-PPC, Inc. v. Guardian Drug Co., Inc., 984 F. Supp. 1066, 1069 (E.D. Mich. 1997); DAP Prods., Inc. Color Tile Mfg., Inc., 821 F. Supp. 488, 492 (S.D. Ohio 1993). However, proof of intentional copying alone is not sufficient to

establish secondary meaning. See Libbey Glass, 61 F. Supp. 2d at 708. Such proof serves only to raise a rebuttable presumption of copying. See id. Proof of some logical reason, other than an intent to capitalize on a plaintiff's mark, is sufficient to rebut the presumption. See id.

Plaintiff devotes considerable time attempting to establish that Defendants were cognizant of LawOffices.net when selecting Lawoffice.com as the designation for the West Legal Directory website, an assertion contested by Defendants. Without recounting all of the parties' arguments, the Court notes that even if Defendants were aware of the existence of Plaintiff's mark, Defendants offer a "logical reason" for copying the mark and thus successfully rebut the presumption. Specifically, Defendants explain the process through which they considered "a variety of existing and potential Internet domain names as candidates for re-naming and expanding the services then offered through the West Legal Directory Web site," located at www.wld com. Defs.' Mem. P. & A. at 5. Defendants submit that they selected the lawoffice.com domain name and mark because they "more readily conveyed to consumers the nature of the legal information and services offered by West." Id.

Moreover, Plaintiff provides no evidence as to Defendants' alleged motivation in copying Plaintiff's mark. "Intentional copying . . . is not actionable under the Lanham Act 'absent evidence that the copying was done with the intent to derive a benefit from the reputation of another.'" Ferrari, 944 F.2d at 1242-43 (quoting Zin-Plas Corp. v. Plumbing Quality AGF Co., 622 F. Supp. 415, 420 (W.D. Mich. 1985)). "'Where the copying by one party of another's product is not done to deceive purchasers and thus derive a benefit from another's name and reputation, but rather to avail oneself of a design which is attractive and desirable, a case of unfair competition is not made out.'" Id. (quoting West Point Mfg.

Co. v. Detroit Stamping Co., 222 F.2d 581, 586 (6th Cir. 1955)). In the instant action, Plaintiff has produced no evidence as to the existence or value of his business' goodwill, and provides no rationale for the alleged copying of Plaintiff's mark. Plaintiff provides no explanation as to why a leviathan such as West would benefit from capitalizing on the reputation of a small business with no customer base.

viii. Summary of secondary meaning analysis

Because of the short period of use, irrelevant customer testimony, limited advertising expenditures, limited number of customers, limited sales, and lack of any compelling evidence indicating that any of the Defendants knew of Plaintiff's mark, let alone intentionally copied Plaintiff's mark with an intent to capitalize on Plaintiff's goodwill, the Court determines that Plaintiff has not presented sufficient evidence to raise a genuine issue of material fact as to whether potential customers would identify LawOffices.net with the specific suite of services offered specifically by Plaintiff. See Herman Miller, 270 F.3d at 314 (stating that "secondary meaning is proven, when, by a preponderance of the evidence, 'it can be determined that the attitude of the consuming public toward the mark denotes a single thing coming from a single source'") (quoting Burke, 871 F.2d at 596). While courts have been willing to find secondary meaning in the absence of consumer surveys and with limited direct consumer testimony, those courts generally have required at least long-term use, extensive advertising, and substantial publicity. See, e.g., Herman Miller, 270 F.3d at 315-16. As Plaintiff has failed to demonstrate that LawOffices.net has acquired secondary meaning, the Court will grant summary judgment to Defendants on Counts I-VI. However, the Court is still left to dispose of the parties' motions as to Count VII.

D. Count VII -- Common law misappropriation

In Count VII, Plaintiff alleges that "Defendants have appropriated the trade value of the lawoffices.net mark in a manner that constitutes reaping where he has not sown, and seeks to take a free ride from the Plaintiff's promotion of the lawoffices.net mark and website." Compl. P 90 at 12. Defendants assert that Count VII is a claim for unfair competition and accordingly should be disposed of pursuant to federal trademark principles as applied to analogous state claims. Defs.' Mem. P. & A. at 7, n.5. Plaintiff asserts that facts pertaining to this claim are disputed and thus summary judgment is not appropriate on Count VII.

As support for their position that Plaintiff's misappropriation claim should be analyzed as an unfair competition claim, Defendants cite to George P. Ballas Buick-GMC, Inc. v. Taylor Buick, Inc., 449 N.E.2d 805, 5 Ohio Misc. 2d 16 (1981), aff'd, 449 N.E.2d 503, 5 Ohio App. 3d 71 (Ohio Ct. App. 1982), in which Defendants assert that the court "labeled plaintiff's claim under § 4165.02 as 'misappropriation claim.'" Defendants' reliance upon Taylor Buick is misplaced.

First, in Taylor Buick, the plaintiff pleaded a claim pursuant to the ODTPA, in support of which plaintiff contended, inter alia, "that the defendants misappropriated its research, design and advertising by copying . . . its advertising design on . . . [a] billboard thereby appropriating plaintiff's property rights in this design." Taylor Buick, 449 N.E.2d at 808. The court did not hold that misappropriation claims are to be treated as ODTPA claims. The court merely endorsed plaintiff's reliance upon the ODTPA as "well-founded" based upon the court's review of the "confusion of source" provisions of the ODTPA. This determination is far from a conclusion that misappropriation claims are to be treated as ODTPA or other unfair competition claims.

Second, the ODTPA itself provides that "this section does not affect unfair trade practices that are otherwise actionable at common law or under other sections of the Revised Code." Ohio Rev. Code § 4165.02(C).

Third, the cases are distinguishable on their respective facts. In Taylor Buick, the plaintiff alleged that "the defendants misappropriated its research, design and advertising by copying and duplicating its advertising design on . . . [a] billboard thereby appropriating plaintiff's property rights in this advertising design." Taylor Buick, 449 N.E.2d at 807. Plaintiff also alleged infringement upon his common law service mark. In the instant action, Plaintiff alleges appropriation of a much more amorphous concept, i.e., "the 'trade value' of the lawoffices.net mark," Compl. P 90 at 12, a term which this Court construes as encompassing Plaintiff's good will, reputation, labor, business methods, and other intangibles that are not otherwise protectable by trademark law.

In the instant action, the Court admittedly finds no Ohio case discussing the misappropriation of "trade value." However, Ohio courts have recognized a separate tort of misappropriation in other contexts, such as misappropriation of trade secrets and misappropriation of another's name or likeness. Notably, the allegations in Count VII closely resemble a common law cause of action recognized in other states and acknowledged in this Circuit, namely the misappropriation of advertising matter and business methods. Relying upon Supreme Court precedent and the common law of misappropriation as developed in numerous states, this Circuit has concluded that "there has been, and perhaps continues to be, a body of law which gives meaning to the term 'misappropriation of advertising ideas or style of doing business business.'" Advance Watch v. kemper National Insurance, 99 F.3d 795, 802. The court in Advance

Watch further clarified that "'misappropriation of advertising ideas or style of doing business' does not necessarily refer only to the common-law tort of misappropriation recognized by the Supreme Court in International News Service v. Associated Press, . . . but we conclude, it does refer to the unauthorized taking or use of interests other than those which are eligible for protection under statutory or common-law trademark." Id.; see also Circle Communications, Inc. v. Hinton, 1975 Ohio Misc. LEXIS 43, at *9, *17, 74 Ohio Op. 2d 356, No. A-746778 (June 2, 1945) (recognizing that the Supreme Court has distinguished misappropriation as a separate cause of action, which "adopts protectable 'quasi-property' values to such things as ideas, information, formulas, designs, and artistic creations").

While the Court makes no determination as to whether Plaintiff has successfully pled a cause of action for this tort, the Court notes that Defendants offer no grounds for summary judgment on this count, other than their claims as to the status of Plaintiff's trademark. See Advance Watch, 99 F.3d at 805 (distinguishing between trademark infringement on the one hand, and "misappropriation of advertising ideas or style of doing business" on the other, and noting that "it is common practice, but not legally precise, to refer to 'misappropriation' of a trademark"). As the Court has no reason to determine that the Ohio Supreme Court would not recognize this cause of action, the Court will deny Defendants' motion for summary judgment on Count VII.

E. Plaintiff's Motion for Summary Judgment

Plaintiff moves for summary judgment only on Counts I-IV of the Complaint, but asserts that summary judgment is inappropriate as to Counts V-VII. As discussed above, Plaintiff cannot maintain a cause of action on Counts I and III-VI because his mark is descriptive, but devoid of

secondary meaning, and thus not entitled to trademark protection. In addition, Plaintiff has withdrawn Count II of the Complaint. Accordingly, the Court will deny Plaintiff's motion in its entirety.

III. CONCLUSION

Based upon the foregoing, the Court will grant Defendants' Motion for Summary Judgment (Doc. No. 50) as to Counts I - VI. However, the Court will deny Defendants' motion as to Count VII. Finally, the Court will deny Plaintiff's Motion for Summary Judgment (Doc. No. 55) in its entirety. Therefore, the sole cause of action that remains is Count VII, Plaintiff's claim for common law misappropriation.

IT IS SO ORDERED.
s/ David A. Katz
U. S. DISTRICT JUDGE
JUDGMENT ENTRY
For the reasons stated in the Memorandum Opinion filed contemporaneously with this entry, IT IS HEREBY ORDERED, ADJUDGED and DECREED that Defendants' Motion for Summary Judgment (Doc. No. 50) is granted as to Counts I - VI and denied as to Count VII
IT IS HEREBY FURTHER ORDERED, ADJUDGED and DECREED that Plaintiff's Motion for Summary Judgment (Doc. No. 55) is denied in its entirety.
s/ David A. Katz
U. S. DISTRICT JUDGE

FOOTNOTES

n1 Plaintiff refers alternatively to the designation LawOffices.net as a trademark and a service mark. For clarity of analysis, the Court notes that it utilizes the terms "mark" or "trademark" to refer to the parties' designations.

Nonetheless, the Court recognizes that the Lanham Act provides separate definitions for "trademark" and "service mark." Trademarks identify goods, while service marks identify "intangible activities, which are performed by one person for the benefit of a person or persons other than himself, either for pay or otherwise." Trademark Manual of Examining Procedure ("TMEP") § 102. A service mark is defined as "any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish the services of one person . . . from the services of others and to indicate the source of the services." 15 U.S.C. § 1127. However, analytical principles that apply to trademarks apply with equal force to service marks.

n2 Plaintiff's mark appears on the website lawoffices.net as follows:
LawOffices.net

n3 Lawoffice.com is redirected to a FindLaw directory page at http://directory.findlaw.com.n4 The disputed mark no longer appears on Defendants' website. However, until recently, Defendants' mark appeared on the website lawoffice.com as follows:
Lawoffice.com from West Legal Directory

n4 See Defs.' Mem. P. & A. at 19.

n5 In Plaintiff's Motion for Summary Judgment, Plaintiff purports to withdraw this claim. See Pl.'s Mot. Summ. J. at 21 (stating that "Plaintiff agrees with defendants analysis of Count II and hereby withdraws this claim").
n6 Section 43(a) of the Lanham Act provides in relevant part:
Any person who, on or in connection with any goods or services, . . . uses in commerce any word, term, name,

symbol, or device, . . . or any false designation of origin . . . which --

(A) is likely to cause confusion, or to cause mistake, or to deceive as to . . . the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act. 15 U.S.C. § 1125(a)(1).

n7 As explained by the Supreme Court:

Descriptive marks may acquire the distinctiveness which will allow them to be protected under the Act. Section 2 of the Lanham Act provides that a descriptive mark that otherwise could not be registered under the Act may be registered if it "has become distinctive of the applicant's goods in commerce." § § 2(e), (f), 15 U.S.C. § § 1052(e), (f). This acquired distinctiveness is generally called "secondary meaning." The concept of secondary meaning has been applied to actions under § 43(a). Two Pesos, 505 U.S. at 770 (citations omitted). Secondary meaning is further discussed infra Part II.C.3.

n8 The parties' submissions reveal wide third-party use of variants of "lawoffice" in business names and websites.

n9 Plaintiff incorrectly asserts that Defendants have the burden of establishing that their mark has acquired secondary meaning. See Pl.'s Reply at 12.

n10 The statute provides in relevant part:
The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark

by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. 15 U.S.C. § 1052(f).

TITLE 15. COMMERCE AND TRADE
CHAPTER 22. TRADEMARKS
THE PRINCIPAL REGISTER

15 USCS § 1052 (2004)

§ 1052. Trademarks registrable on the principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act [19 USCS § 3501(9)]) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely

descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4 [15 USCS § 1054], (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act [enacted Dec. 8, 1993].

A mark which when used would cause dilution under section 43(c) [15 USCS § 1125(c)] may be refused registration only pursuant to a proceeding brought under section 13 [15 USCS § 1063]. A registration for a mark which when used would cause dilution under section 43(c) [15 USCS § 1125(c)] may be canceled pursuant to a proceeding brought under either section 14 [15 USCS § 1064] or section 24 [15 USCS § 1092].

TITLE 15. COMMERCE AND TRADE
CHAPTER 22. TRADEMARKS
GENERAL PROVISIONS

GO TO CODE ARCHIVE DIRECTORY FOR THIS JURISDICTION

15 USCS § 1125 (2004)

§ 1125. False designations of origin and false descriptions forbidden

(a) Civil action.

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which--

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this

Act in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this Act for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

(b) Importation. Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this Act in cases involving goods refused entry or seized.

(c) Remedies for dilution of famous marks.

(1) The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to--

(A) the degree of inherent or acquired distinctiveness of the mark;

(B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;

(C) the duration and extent of advertising and publicity of the mark;

(D) the geographical extent of the trading area in which the mark is used;

(E) the channels of trade for the goods or services with which the mark is used;

(F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;

(G) the nature and extent of use of the same or similar marks by third parties; and

(H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(2) In an action brought under this subsection, the owner of the famous mark shall be entitled only to injunctive relief as set forth in section 34 [15 USCS § 1116] unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If such willful intent is proven, the owner of the famous mark shall also be entitled to the remedies set forth in sections 35(a) and 36 [15 USCS §§ 1117(a), 1118], subject to the discretion of the court and the principles of equity.

(3) The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution of the distinctiveness of a mark, label, or form of advertisement.

(4) The following shall not be actionable under this section:

(A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.

(B) Noncommercial use of a mark.

(C) All forms of news reporting and news commentary.

(d) Cyberpiracy prevention.

(1) (A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person--

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that--

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18, United States Code, or section 220506 of title 36, United States Code.

(B) (i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to--

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by

the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1) of section 43 [subsec. (c)(1) of this section].

(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain

name or the transfer of the domain name to the owner of the mark.

(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E) As used in this paragraph, the term "traffics in" refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2) (A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if--

(i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c); and

(ii) the court finds that the owner--

(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by--

(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb) publishing notice of the action as the court may direct promptly after filing the action.

(B) The actions under subparagraph (A)(ii) shall constitute service of process.

(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which--

(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

(ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

(D) (i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall--

(I) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and

(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

(ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

(4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.

(2)

Supreme Court, U.S.
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No. 03-1422

IN THE

# Supreme Court of the United States

ANTHONY J. DEGIDIO,

*Petitioner,*

*v.*

WEST GROUP CORPORATION; THE THOMSON CORPORATION; WEST LICENSING CORPORATION,

*Respondents.*

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

## BRIEF IN OPPOSITION

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## QUESTION PRESENTED

Whether the United States Court of Appeals for the Sixth Circuit applied the appropriate standard of review in passing on the judgment of the United States District Court for the Northern District of Ohio.

## PARTIES TO THE PROCEEDING

Respondents are satisfied with Petitioner's description of the parties to the proceeding except as follows: West Group is a "d/b/a" of West Publishing Corporation, with its principal place of business in Eagan, Minnesota. The Thomson Corporation is the ultimate parent of West Publishing Corporation.

## CORPORATE DISCLOSURE STATEMENT

The following are parent corporations or publicly held companies that own ten percent or more of West Group's stock:

The Thomson Corporation;
Thomson Canada Limited;
Thomson U.S. Holdings Inc.;
Thomson Corporation U.S.A. Inc.;
Thomcorp. No. 4 Inc.;
Thomcorp. No. 5 Inc.;
THI (U.S.) Inc.;
Thomson U.S. Inc.;
The Thomson Corporation Delaware Inc.;
Thomson Healthcare Inc.;
Thomson Financial Inc.; and
Thomson Legal & Regulatory Inc.

There is no parent or publicly held company owning ten percent or more of The Thomson Corporation's stock.

West Licensing Corporation recently merged into West Publishing Corporation. The following are parent corporations or publicly held companies that own ten percent or more of West Publishing Corporation's stock:

The Thomson Corporation;
Thomson Canada Limited;
Thomson U.S. Holdings Inc.;
Thomson Corporation U.S.A. Inc.;
Thomcorp. No. 4 Inc.;
Thomcorp. No. 5 Inc.;
THI (U.S.) Inc.;
Thomson U.S. Inc.;
The Thomson Corporation Delaware Inc.;
Thomson Healthcare Inc.;
Thomson Financial Inc.; and
Thomson Legal & Regulatory Inc.

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## STATEMENT OF THE CASE

***District Court Proceedings***

Petitioner filed this lawsuit in the United States District Court for the Northern District of Ohio (the "District Court") on August 24, 1999, asserting seven causes of action under federal and Ohio law for trademark infringement, unfair competition, dilution and misappropriation, all of which involve the same basic and undisputed facts. The District Court had jurisdiction over these causes of action pursuant to 15 U.S.C. § 1121(a) and 28 U.S.C. §§ 1331, 1338(a), 1338(b) and 1367(a).

On May 31, 2001, Respondents moved for summary judgment on each of Petitioner's seven causes of action. On June 28, 2001, Petitioner cross-moved for summary judgment on four of his causes of action concerning unfair competition and trademark infringement.

On March 18, 2002, in a memorandum opinion, the District Court granted Respondents' motion for summary judgment on six of the seven causes of action and denied Petitioner's motion for summary judgment.[1] (*See generally* App. 19-48.)

The District Court identified the following undisputed facts:

---

1. As to the single remaining cause of action, common law misappropriation, the District Court granted Respondents' renewed motion for summary judgment on May 23, 2002.

***Petitioner's Activities***

In 1996 (App. 36), Petitioner, a lawyer whose "practice is focused on cyberlaw and intellectual property issues" (App. 33), registered the domain name <lawoffices.net> (App. 20). Petitioner began using the LawOffices.net designation in connection with an Internet Web site, "which provides an attorney directory, legal information relating to cyberlaw issues, a vanity email service, listings of domain names for sale, and a hosting service for legal related websites." (App. 20.)

Petitioner "does not own either a federal or state registration for the LawOffices.net designation." (App. 20.) "The essential features of [Petitioner's] putative trademark are: (1) a capitalization of the letters 'l' and 'o;' (2) pluralization of 'lawoffice;' and (3) placement of the term 'LawOffices.net' in black font in a horizontal rectangular box that is shaded in marbled white and light gray." (App. 20.) Petitioner's mark appears on the Web site located at www.lawoffices.net as follows:

. (App. 46.)

Petitioner "has spent $2,500 over four years to advertise and promote his website." (App. 38.) Petitioner "has not engaged in direct mail, print, radio or television advertising of the LawOffices.net Web site." (App. 38.) "While [Petitioner] has spent $2,500 on advertising, he does not establish that these expenditures are extensive, nor that the expenditures are beyond that necessary for market survival." (App. 38.)

Petitioner "has earned no revenue from services he provides through his website, . . . he has never had a paying customer, has never had any employees, and has earned less than $ 200 in revenue from banner advertisements and click-through revenues." (App. 39.)

Petitioner "offers the affidavits from three people who have accessed the lawoffices.net website, but provides no further evidence of a customer base." (App. 39; *accord* App. 35.) Petitioner "does not offer testimony from a single customer who states that he associates LawOffices.net solely with [Petitioner] or that he visited the lawoffices.net website because he identified the moniker with a particular source of services." (App. 35-36.)

***Respondents' Business***

In 1999, Respondents "considered 'a variety of existing and potential Internet domain names as candidates for re-naming and expanding the services then offered through the West Legal Directory Web site,' located at www.wld.com." (App. 40.) Respondents "selected the lawoffice.com domain name and mark because they 'more readily conveyed to consumers the nature of the legal information and services offered by [Respondents].'" (App. 40.)

In June 1999 (App. 37), Respondents started using "the designation Lawoffice.com and the domain name 'lawoffice.com' to market . . . [an] online resource for useful information pertaining to law and lawyers for businesses, professional[s] and consumers.'" (App. 20-21.) Respondents' "website offers information on over four hundred legal topics, a directory of attorneys and other legal professionals, an online searchable legal dictionary, and a frequently asked

questions section." (App. 21.) "In addition to the aforementioned services, [Respondents] also offer[] fee-based services, including email, website creation and hosting, and sponsorship packages." (App. 21.) "However, these fee-based services are not advertised at the Lawoffice.com website." (App. 21.)

> The essential features of the designation Lawoffice.com are: (1) capitalization of the letter 'l;' (2) singular, as opposed to plural, 'lawoffice;' (3) italicization of 'law;' (4) placement of Lawoffice.com in white font in a dark blue rectangular box; (5) a multi-colored open door emblem situated over the 'dot;' and (6) the text 'from West Legal Directory' placed in smaller white font beneath Lawoffice.

(App. 21.) "Lawoffice.com is redirected to a FindLaw directory page at http://directory.findlaw.com." (App. 46.) "The disputed mark no longer appears on [Respondents'] website." (App. 46.) "However, until recently, [Respondents'] mark appeared on the website lawoffice.com as follows:

." (App. 46.)

***Third-Party Uses of "Lawoffice"***

"[O]thers obviously have utilized permutations of LawOffices.net in order to represent their own suite of legal services." (App. 33.) "Both sides have submitted information, including telephone directory listings and website search engine results, indicating that there are numerous organizations and websites utilizing the term 'lawoffice' to represent their business." (App. 37.)

Based on these undisputed facts, the District Court held that "[Petitioner's] mark is not entitled to [trademark] protection because it is descriptive and devoid of secondary meaning." (App. 26.) Therefore, the District Court granted summary judgment to Respondents and against Petitioner on his causes of action for trademark infringement, unfair competition and dilution. (App. 41.)

***Court of Appeals Proceedings***

On June 22, 2002, Petitioner filed a notice of appeal in the United States Court of Appeals for the Sixth Circuit ("Court of Appeals"). Petitioner claimed that the District Court erred "when it determined that his mark LAWOFFICES, was descriptive and that it had not acquired secondary meaning." (App. 2.)

The Court of Appeals reviewed the District Court's "grant of summary judgment de novo." (App. 3.) Thus, in reviewing the District Court's grant of summary judgment, the Court of Appeals applied the same standard that was employed by the District Court initially under Federal Rule of Civil Procedure 56(c). (App. 3 (citing *Terry Barr Sales Agency, Inc. v. All-Lock Co., Inc.*, 96 F.3d 174, 178 (6th Cir. 1996).) The Court of Appeals stated that "[s]ummary judgment is appropriate where 'there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law.'" (App. 3 (citing Fed. R. Civ. P. 56(c).)

The Court of Appeals "view[ed] the evidence and dr[e]w all 'justifiable inferences' in the light most favorable to" Petitioner. (App. 3 (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986).) Affirming the District Court's

decision, the Court of Appeals agreed that Respondents were entitled to judgment as a matter of law because Petitioner's putative trademark LAWOFFICES was descriptive and had not acquired secondary meaning. (App. 2.)

## SUMMARY OF THE ARGUMENT

It is well established that the proper standard of review of a trial court's order granting summary judgment is *de novo*. Thus, the Court of Appeals relied on well-established precedent when it applied a *de novo* standard of review to the District Court's order granting summary judgment. Despite this well-established precedent, Petitioner suggests that the Court of Appeals should have set aside findings of fact of the District Court that were "clearly erroneous" within the meaning of Federal Rule of Civil Procedure 52(a). However, Federal Rule of Civil Procedure 52(a) and thus, *Icicle Seafoods, Inc. v. Worthington*, 475 U.S. 709 (1986), do not apply to decisions on summary judgment motions.

## THE ARGUMENT

There can be no dispute about the proper standard of review of the District Court's order granting Respondents' motion for summary judgment. The Court of Appeals reviews the District Court's grant of summary judgment *de novo*, applying the same legal standards used by the District Court. *See, e.g., Agosto v. I.N.S.*, 436 U.S. 748, 756-57 (1978); *Brown v. Crawford*, 906 F.2d 667, 669 (11th Cir. 1990); *Williams v. Widnall*, 79 F.3d 1003, 1005 (10th Cir. 1996); *Vieux v. E. Bay Regional Park Dist.*, 906 F.2d 1330, 1332 (9th Cir. 1990). "Summary judgment is appropriate where 'there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law.'"

(App. 3 (citing Fed. R. Civ. P. 56(c) (internal quotations omitted).) The Court of Appeals, like the District Court, must view the evidence "in the light most favorable to the nonmoving party," *Siegal v. Fed. Home Loan Mortgage Co.*, 143 F.3d 525, 528 (9th Cir. 1998) and "all justifiable inferences are to be drawn in his favor," *Anderson*, 477 U.S. at 255. Thus, the Court of Appeals performs the same basic and well-settled role as the District Court, that is, as a gatekeeper against factually unsupported claims not worthy of jury consideration.

The Court of Appeals—fulfilling its duty as gatekeeper—followed the proper procedures; it "view[ed] the evidence and dr[e]w all 'justifiable inferences' in the light most favorable to" Petitioner. (App. 3 (citing *Anderson*, 477 U.S. at 255).) In fact, the Court of Appeals noted that "the district court did not necessarily view evidence in light most favorable to [Petitioner] when it applied the six-factor McCarthy test" and determined that Petitioner's putative trademark was descriptive. (App. 9.) The Court of Appeals then correctly "view[ed] the evidence in the light most favorable to [Petitioner]" and found that "the mark LAWOFFICES lies very close to the descriptive end of the continuum." (App. 9.) Because the Court of Appeals found that Petitioner's LAWOFFICES putative trademark was descriptive, it appropriately noted that Petitioner must establish that his putative trademark has acquired secondary meaning. (App. 9-10.) The Court of Appeals viewed the evidence in the light most favorable to Petitioner, applied the seven-factor test used by courts in the Sixth Circuit to determine whether a mark has acquired secondary meaning, and agreed with the District Court that Petitioner had failed to meet his burden of establishing a secondary meaning for his putative trademark. (App. 9-12.)

Despite that well-established precedent states that reviewing courts employ a *de novo* standard in reviewing decisions on summary judgment, Petitioner suggests that the Court of Appeals should have set aside findings of fact of the District Court that were "clearly erroneous" within the meaning of Federal Rule of Civil Procedure 52(a). (Pet. at 5.) However, Rule 52(a) specifically states that "[f]indings of fact . . . are unnecessary on decisions on motions under Rules 12 or 56." Thus, Petitioner's claim that the Court of Appeals must be bound by Federal Rule of Civil Procedure 52(a) and, by extension, this Court's decision in *Icicle Seafoods*, 475 U.S. 709, is incorrect.

In *Icicle Seafoods*, the district court presided over a two-day bench trial, 475 U.S. at 710, and thus, was required to issue findings of facts under Federal Rule of Civil Procedure 52(a). Fed. R. Civ. P. 52(a) ("In all actions tried upon the facts without a jury . . . , the court shall find the facts specially"). These "[f]indings of fact . . . shall not be set aside unless clearly erroneous." *Id.* While the court of appeals proposed to "review the facts under a clearly erroneous standard . . . nowhere it its opinion did the court ever mention any of the factual findings of the District Court, much less discuss or analyze them." 475 U.S. at 713. Instead, unlike here, the court of appeals improperly "made factual findings on its own."[2] *Id.* at 714. Thus, this Court vacated the

2. Petitioner claims incorrectly that the Court of Appeals "dispensed with the issue" of likelihood of confusion and engaged in improper fact finding regarding this issue. (*See* Pet. at 7.) The passage from the Court of Appeals decision Petitioner quotes specifically addresses the question of "whether 'LAWOFFICES' is a suggestive or a descriptive mark," not the question of likelihood of confusion. (Pet. at 7 (citing App. 9).) Moreover, neither the Court of (Cont'd)

judgment of the court of appeals. *Id.* at 715. Because this case was decided by summary judgment, *Icicle Seafoods* and Federal Rule of Civil Procedure 52(a) do not apply. *See, e.g.*, *Wooden v. Bd. of Regents of Univ. Sys. of Ga.*, 247 F.3d 1262, 1271 n.9 (11th Cir. 2001) ("a district court does not make factual findings in deciding a summary judgment motion, so no question of clear error review even arises here."); *Rosen v. Bezner*, 996 F.2d 1527, 1530 n.2 (3d Cir. 1993) ("because summary judgment may only be granted where there is no genuine issue of material fact, any purported 'factual findings' of the [trial] court cannot be 'factual findings' as to disputed issues of fact, but rather are conclusions as a matter of law that no genuine issue of material fact exists"); *Spannaus v. United States Dep't of Justice*, 813 F.2d 1285, 1288 n.4 (4th Cir. 1987) ("Any findings of fact made on a summary judgment motion, however, are not 'entitled to the protection of the "clearly erroneous" rule on review.'").

In this case, although not required to do so pursuant to Rule 52(a), the District Court issued a memorandum opinion setting forth the undisputed facts supporting its decision. *See* discussion *supra* pages 2-4. The Court of Appeals was thus able to use the District Court's memorandum to aid it in

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(Cont'd)

Appeals nor the District Court addressed the issue of likelihood of confusion—nor were they required to do so—because Petitioner had not satisfied the threshold requirement that his putative mark was entitled to trademark protection. (App. 4 (citing cases) ("As the district court correctly noted, in order to prevail on any of the first six counts, Plaintiff must establish that the designation 'LawOffices.net' is indeed a valid and legally protectable trademark.").) Petitioner himself admits as much. (Pet. at 4 ("*After* determining that there is a mark deserving protection courts consider whether or not there is a likelihood of confusion.") (emphasis added).)

the reviewing process. *See, e.g., United States ex rel. Indus. Instrument Corp. v. Paul Hardeman, Inc.*, 320 F.2d 115, 116 (5th Cir. 1963); *Jarrett v. Norfolk Redevelopment & Hous. Auth.*, 74 F. Supp. 585, 586 (E.D. Va. 1947), *aff'd*, 169 F.2d 409 (4th Cir. 1948). However, ultimately, the role of the Court of Appeals is to determine (i) whether there exists a genuine issue of material fact resolvable only at trial and (ii) whether the moving party is entitled to a judgment as a matter of law. *See* Fed. R. Civ. P. 56(a). The Court of Appeals did just that. Neither party argued that there existed disputed issues of material fact; in fact, the parties cross-moved for summary judgment. The Court of Appeals decision raises no appropriate issue for review by this Court.

## CONCLUSION

Because the Court of Appeals applied the appropriate standard of review in passing on the judgment of the District Court, the Petition should be denied.

Respectfully submitted,

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